119 (1)

Supreme Court, U.S.
FILED
081031 FEB 2 - 2009
OFFICE OF THE CLERK

No.

IN THE
Supreme Court of the United States

EGYPTIAN GODDESS, INC., PETITIONER

v.

SWISA, INC. AND DROR SWISA

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED

Whether the ordinary observer test for design patent infringement requires that the patented design, accused design, and prior art designs are compared to each other by considering the visual effect of each design as a whole.

RULE 29.6

Petitioner Egyptian Goddess, Inc. has no parent corporations, and there are no publicly held companies that hold 10% or more of petitioner's stock.

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OPINIONS BELOW

The en banc opinion of the Federal Circuit is reported at 543 F.3d 665 and is reprinted at App. 1a-35a. The order denying the petition for rehearing en banc is unofficially reported at 2008 U.S. App. LEXIS 25269 and is reprinted at App. 60a. The vacated panel opinion of the Federal Circuit is reported at 498 F.3d 1354 and is reprinted at App. 40a-52a. The opinion of the Federal Circuit granting the petition for rehearing en banc is unofficially reported at 256 Fed. Appx. 357; 2007 U.S. App. LEXIS 27456 and is reprinted at App. 36a-39a. The district court opinion granting summary judgment is unofficially reported at 2005 U.S. Dist. LEXIS 32931 and is reprinted at App. 53a-59a.

JURISDICTION

The judgment of the Federal Circuit was entered on September 22, 2008. Petitioners timely filed a petition for rehearing en banc, which was denied on November 4, 2008. The Petition for Writ of Certiorari is due on February 2, 2009. This Court has jurisdiction under 28 U.S.C. § 1254(1).

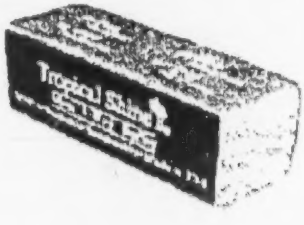
RELEVANT PROVISIONS INVOLVED

None.

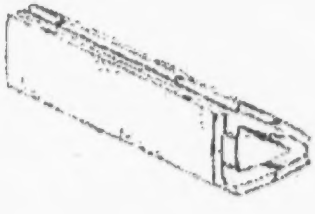
STATEMENT

Egyptian Goddess, Inc. (Egyptian Goddess) is the exclusive licensee of all right, title and interest in and to United States Design Patent No. D467,389 ("the D'389 Patent) issued on December 17, 2002 by the United

States Patent and Trademark Office. (JA38). Swisa, Inc. (Swisa) sold a nail buffer substantially similar in distinctive appearance to the D'389 Patent in that the Swisa buffer has a hollow and open ended tube, square in cross section and rectangular in length, with multiple raised rectangular buffer pads mounted on the sides that do not cover the corners of the tube. (JA300-JA301). The Swisa buffer has one more buffer pad than the patented design. The prior art includes solid block buffers (e.g., Falley Buffer Block) and Design Patent No. 416,648 to Letherby (the D'648 Patent, "Nailco" buffer, or "Nailco Patent") (JA383). The two prior art buffers and the accused and patented designs are as follows:

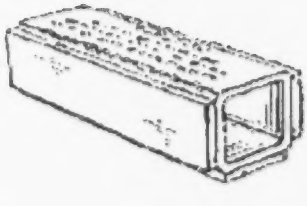


Falley Buffer Block



Nailco Patent

Swisa Buffer



'389 Patent

An expert witness for Egyptian Goddess, Kathleen Eaton, stated in relevant part as follows in a declaration dated May 3, 2005 (JA334-JA335):

> 4. Over the years, I have sold thousands of nail buffers to customers. The nail buffers were in a variety of designs, including block buffers. In my experience, when purchasing a nail buffer, customers do not know the difference between, or express a preference for, a "three way" or a "four way" nail buffer.
>
> 5. I have looked at the nail buffer design depicted in United States Patent D467,389 (patented design). I also have looked at the nail buffer accused of infringement in the above-styled case (accused nail buffer).
>
> 6. In my opinion an ordinary observer and purchaser of nail buffers would consider that the patented design and the accused nail buffer have a substantially similar appearance in overall design, particularly in light of other nail buffers, such as a solid block buffer and the hollow triangular Nailco buffer. In my opinion, the substantially similar appearance in overall design results from both designs having a hollow tube, square in cross section and rectangular in length, with multiple raised rectangular pads mounted on the sides, and that do not cover the corners of the tube.
>
> 7. I understand that the accused nail buffer has one more buffer pad than the patented design. However, I do not believe that, to an

ordinary observer and purchaser of nail buffers, the presence of one more buffer pad greatly alters the ornamental effect and appearance of the whole design as compared to the whole patented design.

8. In my opinion, the overall designs of the patented design and the accused nail buffer are so similar that in the eyes of an ordinary observer and purchaser of nail buffers, their resemblance is such as to confuse an ordinary observer into purchasing the accused buffer thinking it to be the patented buffer design.

On March 21, 2003, Egyptian Goddess sued Swisa, Inc. and Dror Swisa for patent infringement in the Northern District of Texas, *Egyptian Goddess, Inc. v. Swisa, Inc., et al.*; Civil Action No. 3-03-CV-0594-N. (JA23; JA37-JA40). Swisa filed an answer and a declaratory judgment counterclaim on April 10, 2003. (JA23; JA41-JA46). Egyptian Goddess answered the counterclaim on April 23, 2003. (JA23; JA47-JA49). On January 21, 2004, Swisa filed a first amended answer and counterclaim against Egyptian Goddess and a third-party complaint against Adi Torkiya. (JA25; JA50-JA56). On February 19, 2004, Egyptian Goddess and Adi Torkiya filed a first amended answer to counterclaim and third party complaint. (JA25; JA57-JA61). A motion for claim construction was filed on October 18, 2004 (JA27), and an order construing the claim of the subject Patent was entered on March 7, 2005 (JA9-JA13).

Swisa filed a motion for summary judgment (JA62-JA63) with brief (JA64) and appendix (JA96) on

April 1, 2005. Egyptian Goddess responded (JA289) with appendix (JA333), and Swisa replied (JA419). The district court granted Swisa's motion for summary judgment of non-infringement on December 14, 2005. (JA2-JA8). Both parties filed motions for reconsideration (JA30), and both motions were denied by order entered January 30, 2006. (JA31).

A final judgment was entered by the district court on July 6, 2006, which (1) ordered that Egyptian Goddess take nothing by its claims for patent infringement against Swisa and dismissed those claims with prejudice, and (2) ordered that Swisa's declaratory judgment claims against Egyptian Goddess and Adi Torkiya be dismissed without prejudice. (JA1). Costs of court were taxed in favor of Swisa and against Egyptian Goddess. (JA1). Egyptian Goddess filed a notice of appeal on August 1, 2006. (JA14-JA15). An appeal followed.

Egyptian Goddess filed a brief, Swisa responded, and Egyptian Goddess replied. Oral argument was held on March 5, 2007. By opinion dated August 29, 2007, the United States Court of Appeals for the Federal Circuit (Federal Circuit) affirmed the district court's order. Egyptian Goddess timely filed a combined petition for panel rehearing and rehearing en banc. Swisa responded. On November 26, 2007, the Federal Circuit denied the petition for panel rehearing, granted the petition for rehearing en banc, vacated the opinion dated August 29, 2007, and reinstated the appeal. The parties were requested to file briefs.

Oral argument was held on June 2, 2008. By opinion dated September 22, 2008, the Federal Circuit

eliminated the "point of novelty" test as a separate test for design patent infringement but affirmed the district court's order under the Federal Circuit's interpretation of the ordinary observer test as established by this Court in *Gorham v. White*, 81 U.S. 511 (1871). Egyptian Goddess timely filed a petition for rehearing en banc. On November 4, 2008, the Federal Circuit denied the petition for rehearing en banc.

REASONS FOR GRANTING THE PETITION

This Court should grant this petition for writ of certiorari to correct the Federal Circuit's erroneous interpretation of the *Gorham v. White* "ordinary observer" design patent infringement test. Although the Federal Circuit eliminated the well intended but ultimately unworkable "point of novelty" test in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc), the Federal Circuit erred by failing to hold that when the patented and accused designs are compared in light of the prior art designs, the comparison is to be conducted by viewing the visual effect of each design *as a whole*. In fact, the Federal Circuit did not view the designs as a whole. Rather, the court selected only portions of the accused design and a prior art design for comparison. The Federal Circuit's failure to consider the designs as a whole is contrary to this Court's holding in *Gorham*. Indeed, when the Federal Circuit's holding and rationale in *Egyptian Goddess* are applied to the spoon designs in *Gorham*, a result contrary to this Court's holding in *Gorham* is reached.

This Court can prevent such an erroneous interpretation of *Gorham* by expressly requiring that

the patented design, accused design, and prior art designs are compared with each other by considering the visual effect of each *as a whole*. This Court in *Gorham* expressly stated that "the question remains, is the effect of the *whole design* substantially the same?" *Gorham* at 530. (emphasis added). The requirement of comparing the accused design as a whole with the prior art designs as a whole was not expressly set forth in *Gorham* because the prior art designs were not specifically mentioned or described in the *Gorham* opinion. However, such a requirement exists by necessary implication in light of the infringement finding in *Gorham* and the contrary result that would be achieved if the Federal Circuit's *Egyptian Goddess* analysis is applied to the *Gorham* spoon designs.

1. *Gorham v. White* and the Ordinary Observer Test for Design Patent Infringement

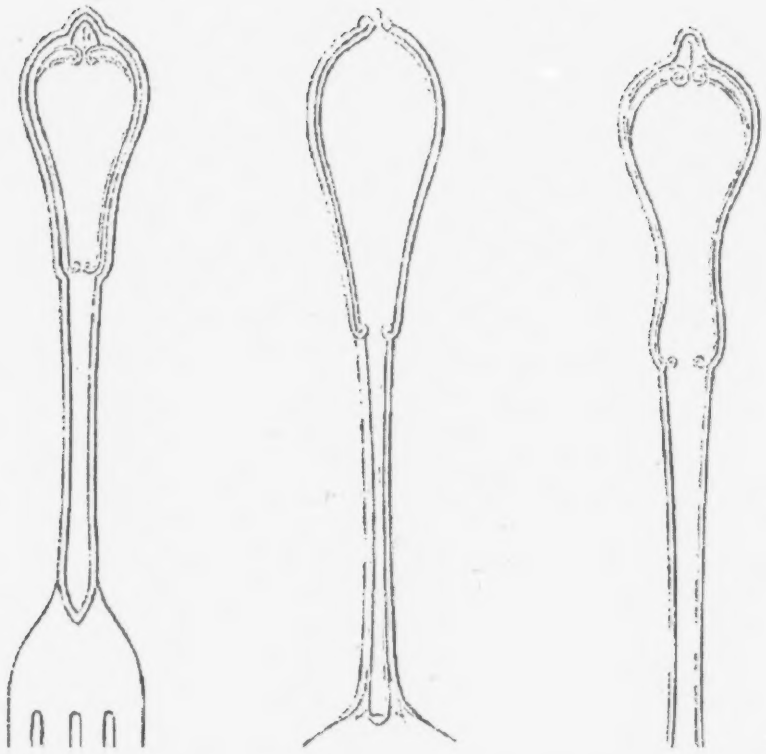
In *Gorham Co. v. White*, 81 U.S. 511 (1871), this Court established the test for design patent infringement. This Court held that "if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other." *Id.* at 528. This Court also explained that the "controlling consideration" was whether the "effect" of the designs was the same. *Id.* at 525, 526. ("We do not say that in determining whether two designs are substantially the same, differences in the lines, the configuration, or the modes by which the aspects they exhibit are not to be considered; but we think the

controlling consideration is the resultant effect."). The "main test of substantial identity of appearance" was considered to be "sameness of effect upon the eye," *Id.* at 527, and "though variances in the ornament are discoverable, the question remains, is the effect of the *whole design* substantially the same?" *Id.* at 530. (emphasis added).

Cases following *Gorham* emphasized "that on the issue of infringement a design patent is not infringed by anything which does not present the appearance which distinguishes the design claimed in the patent from the prior art." *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 429 (6th Cir. 1933) (and cases cited therein). Although the "distinctive appearance" principle was not expressly stated as a requirement for infringement in *Gorham*, a careful review of this Court's infringement analysis indicates that the principle had been satisfied. In *Gorham*, this Court stated:

> Applying this rule to the facts of the present case, there is very little difficulty in coming to a satisfactory conclusion. The Gorham design, and the two designs sold by the defendant, which were patented to White, one in 1867, and the other in 1868, *are alike the result of Peculiarities of outline, or configuration, and of ornamentation.* These make up whatever is *distinctive in appearance*, and of these, the outline or configuration is most impressive to the eye.

Id. at 528-529. (emphasis added).



White 1867 Gorham White 1868

For source of spoon design drawings *see* http://www.aipla.org/Content/Microsites150/Industrial_Designs/Industrial_Designs_Articles_and_Presentations/The_Death_of_Gorham_v._White.OCT05.pdf (Presentation by Perry J. Saidman).

"Distinctive" is a comparative term. The Gorham and White designs could not accurately be described as "distinctive" unless they were being compared against the prior art spoon designs that an ordinary observer was generally familiar with.

In *Applied Arts*, the court found no conflict between the *Gorham* ordinary observer test and the requirement that the accused design must present the appearance that distinguished the patented design from the prior art. The full rationale of the court is worth reproducing:

> It has been held, however, that a design patent stands on as high a plane as utility patents, [cites omitted], and that on the issue of infringement a design patent is not infringed by anything which does not present the appearance which distinguishes the design claimed in the patent from the prior art. [cites omitted]. Thus is presented a difficulty. The Supreme Court has said (*Gorham v. White, supra*) that sameness of effect upon the eye is the main test of substantial identity of design, but it is not essential that the appearance should be the same to the eye of the expert. It is sufficient if it is the same to the ordinary observer. Yet it is clearly the rule that similitude of appearance is to be judged by the scope of the patent in relation to the prior art. The question at once presents itself: Are these tests of identity in conflict? What does the ordinary observer, at least in the common acceptation of that phrase, know of the prior art? If the two tests are to be reconciled, some qualification must be recognized as applied to the ordinary observer. A careful analysis of *Gorham v. White*, and other adjudicated cases supplies the answer. The ordinary observer is not any observer, but one who, with less than the trained faculties of the expert, is "a purchaser of things of similar design," or "one

> interested in the subject." The mythical prudent man in negligence cases is not the Hottentot or Abyssinian who has never seen a locomotive or driven an automobile, but one who has average familiarity with such instrumentalities, and can form a reasonable judgment as to their speed and mode of operation. So is the average observer not one who has never seen an ash tray or a cigar lighter, but one who, though not an expert, has reasonable familiarity with such objects, and is capable of forming a reasonable judgment when confronted with a design therefor as to whether it presents to his eye distinctiveness from or similarity with those which have preceded it. This view is confirmed by the factual analysis which the Supreme Court gave to the evidence in the *Gorham* Case, laying its greatest stress upon the evidence of sameness there given by the large number of witnesses "familiar with designs, and most of them engaged in the trade."

Applied Arts, supra, at 429, 430.

The court reasoned there was no conflict because the ordinary observer, who already possessed reasonable familiarity with the prior art,[1] necessarily

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[1] In *Gorham,* this Court held that ordinary observers were not experts. Rather, ordinary observers were observers of "ordinary acuteness," having "ordinary intelligence," and who "are the principal purchasers of the articles to which designs have been given novel appearances." *Gorham, supra,* at 528. This Court disagreed with the lower court's opinion that "there could be no infringement unless there was 'substantial identity' 'in view of the observation of a person versed in designs in the particular trade in

made the comparison in relation to the prior art. The requirement that the accused design must present the appearance that distinguished the patented design from the prior art was not a second test distinct from the ordinary observer test, but was rather *part of the ordinary observer test* and a necessary requirement of infringement.

Importantly, the court stated that the accused design had to present the *appearance* that distinguished the patented design from the prior art. Although there was consideration of the individual design elements that contributed to the distinct appearance, the court did not attempt to identify a precise point of novelty in the patented design and then determine whether the accused design contained that point of novelty. Rather, the ultimate consideration was whether the overall appearance that distinguished the patented design from the prior art also was present in the accused design. The court's analysis was consistent with the *Gorham* teaching that "[w]e do not say that in determining whether two designs are substantially the same, differences in the lines, the configuration, or the modes by which the aspects they exhibit are not to be considered; but we think the controlling consideration is the resultant effect." *Gorham*, *supra*, at 526.

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question – of a person engaged in the manufacture or sale of articles containing such designs – of a person accustomed to compare such designs one with another, and who sees and examines the articles containing them side by side.'" *Id.* at 527.

The court's opinion then explained why it was important to make the comparison in relation to the prior art:

> So viewing the test that is to be applied on the issue of infringement, it appears to us that while there is some similarity between the patented and alleged infringing designs, which without consideration of the prior art might seem important, yet such similarity as is due to common external configuration is no greater, if as great, between the patented and challenged designs as between the former and the designs of the prior art. .... There are differences of course in lines and curves between the outer configuration of the patented design and those noted in the prior art, but such differences are no greater than those that exist between the patented design and the alleged infringing designs.

Applied Arts, supra, at 430. In short, it was important to make the comparison in relation to the prior art because designs that may appear similar in isolation may appear different when compared in light of the prior art.

The court also used a practical test for analyzing infringement. When the accused design differed from the patented design more widely than the patented design differed from the prior art, there was no infringement. This practical test had been used in other cases as well. *See, e.g., Bevin Bros. Mfg. Co. v. Starr Bros. Bell Co.*, 114 F. 362, 363 (U.S. Court of Appeals 1902) ("The shape of defendants' bell

differs from plaintiff's more widely than plaintiff's differs from the [bell shaped] door knob, and therefore defendants' construction does not infringe the patent."). The practical test made sense because if the ordinary observer was able to distinguish the patented design from the prior art, and the differences between the accused design and the patented design were greater than the differences between the patented design and the prior art, then the ordinary observer also was able to distinguish between the accused and patented designs.

The Court in *Applied Arts* also made a useful observation concerning the ability of an ordinary observer to distinguish designs when the prior art was crowded:

> We are quite aware that similarity is not to be determined by making too close an analysis of detail, yet where in a crowded art the composite of differences presents a different impression to the eye of the average observer (as above defined), infringement will not be found.

Applied Arts, *supra*, at 430. This made sense because an ordinary observer accustomed to making distinctions based on relatively minor differences in a crowded field was less likely to be confused by general design similarities.

In sum, the test for design patent infringement as expressed in *Gorham* and *Applied Arts* was whether the appearance of the patented and accused designs had such similar effect upon the eye that an ordinary observer would purchase the accused design thinking

that it was the patented design. The comparison was made in relation to the prior art, which as a practical matter, meant three things. First, to infringe, the accused design had to present the appearance that distinguished the patented design from the prior art. Second, if the accused design differed from the patented design more widely than the patented design differed from the prior art, then there was no infringement. Third, when the prior art was crowded, the ordinary observer made a more discriminative examination and comparison of the patented and accused designs, which meant that the scope of the design patent was construed more narrowly in a crowded field of prior art.

2. The Federal Circuit's Point of Novelty Test

The Federal Circuit's first design patent case involving issues of infringement was *Litton Systems, Inc. v. Whirlpool Corporation*, 728 F.2d 1423 (Fed. Cir. 1984).[2] In *Litton Systems*, the court acknowledged the *Gorham* and *Applied Arts* principles that (1) the *Gorham* "ordinary observer" test was the test for design patent infringement, (2) to infringe the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art, (3) if the accused design differed from the patented design more widely than the patented design differed from the prior art, then there was no infringement, and (4) when

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[2] Two earlier design patent cases before the Federal Circuit involved issues of validity (*In re Salmon*, 705 F.2d 1579 (Fed. Cir. 1983) and double patenting (*Carman Industries, Inc. v. Wahl*, 724 F.2d 932, 940 (Fed. Cir. 1983)).

the prior art was crowded with generally similar designs, the range of equivalents[3] was construed narrowly.

However, in *Litton Systems* the Federal Circuit did not state that the "novelty" requirement was part of the ordinary observer test. Rather, the court appeared to treat the novelty requirement as separate from the ordinary observer test. The court stated:

> For a design patent to be infringed, however, no matter how similar two items look, "the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art." [cite omitted]. *That is, even though the court compares two items through the eyes of the ordinary observer, it must nevertheless, to find infringement, attribute their similarity to the novelty which distinguishes the patented device from the prior art.*

Litton Systems, supra, at 1444. (emphasis added).

The italicized statement suggested that the test for design patent infringement was performed in two distinct steps. First, the court compared the two designs through the eye of an ordinary observer. Second, if the designs were confusingly similar to an ordinary observer, then to find infringement the court must attribute the similarity to the novelty that distinguished the patented design from the prior art.

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[3] The Federal Circuit has stated that "it has long been recognized that the principles of equivalency are applicable under *Gorham*." *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1189 (Fed. Cir. 1988)).

The "two distinct tests" approach is, in fact, the way the Federal Circuit expressed the design patent infringement test after *Litton Systems*. *See Shelcore, Inc. v. Durham Industries, Inc.*, 745 F.2d 621, 629 (Fed. Cir. 1984) (*Litton* ... supplements the [ordinary observer] test with the requirement that "the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art."); *Sun Hill Indus. v. Easter Unlimited*, 48 F.3d 1193, 1197 (Fed. Cir. 1995) ("Beyond the substantial similarity requirement of *Gorham* and *L.A. Gear*, design patent infringement requires that the accused product 'appropriate the novelty in the patented device which distinguishes it from the prior art.'") (quoting *Litton*); *Arminak & Assocs. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1320 (Fed. Cir. 2007) ("In a separate and distinct inquiry, the 'point of novelty' test requires proof that the accused design appropriated the novelty which distinguishes the patented design from the prior art.").

Although the separate and distinct point of novelty test was an effort to bring needed objectivity to design patent infringement analysis, the test proved unworkable in practice. It often was extremely difficult, if not impossible, to consistently and predictably identify a single point of novelty in a design, particularly when the design was complex and was being compared against multiple prior art designs. Further, when the "novelty" (distinctiveness from the prior art) requirement was separated from the ordinary observer test, designs that were in the prior art or obvious over the prior art could satisfy the ordinary observer test. Although the separate "point of novelty" test prevented exact prior art designs from being

captured under the infringement test,[4] there was nothing to prevent designs obvious in light of the prior art from being considered infringements. In *Egyptian Goddess*, the Federal Circuit abandoned the point of novelty test and held that "the 'ordinary observer' test should be the sole test for determining whether a design patent has been infringed." (App. 24a).

3. Federal Circuit's Erroneous Interpretation of the Ordinary Observer Test

Although the Federal Circuit eliminated the well intended but ultimately unworkable point of novelty test in *Egyptian Goddess*, the court did not hold that the comparison of the patented and accused designs done in light of the prior art was to be conducted by viewing all the designs *as a whole*. In fact, the court did not view the designs as a whole. Rather, the Court arbitrarily selected portions of the accused design and a prior art design for comparison. This is clear from the court's analysis of the declaration of Ms. Kathleen Eaton.

Ms. Kathleen Eaton, an expert witness for Egyptian Goddess, expressed her opinion in a declaration dated May 3, 2005 concerning whether an ordinary observer would be deceived due to the substantial similarity between the patented and accused designs. True to *Gorham*, Ms. Eaton's opinion was expressed in terms of the similarity of the "overall

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[4] An accused design that is an exact copy of a prior art design will not possess the "point of novelty" that distinguishes the patented design from the copied design.

design" and "ornamental effect and appearance of the whole design" of the patented and accused designs. Ms. Eaton declared in relevant part as follows:

> 5. I have looked at the nail buffer design depicted in United States Patent D467,389 (patented design). I also have looked at the nail buffer accused of infringement in the above-styled case (accused nail buffer).
>
> 6. In my opinion an ordinary observer and purchaser of nail buffers would consider that the patented design and the accused nail buffer have a substantially similar appearance in overall design, particularly in light of other nail buffers, such as a solid block buffer and the hollow triangular Nailco buffer. In my opinion, the substantially similar appearance in overall design results from both designs having a hollow tube, square in cross section and rectangular in length, with multiple raised rectangular pads mounted on the sides, and that do not cover the corners of the tube.
>
> 7. I understand that the accused nail buffer has one more buffer pad than the patented design. However, I do not believe that, to an ordinary observer and purchaser of nail buffers, the presence of one more buffer pad greatly alters the ornamental effect and appearance of the whole design as compared to the whole patented design.
>
> 8. In my opinion, the overall designs of the patented design and the accused nail buffer are

> so similar that in the eyes of an ordinary observer and purchaser of nail buffers, their resemblance is such as to confuse an ordinary observer into purchasing the accused buffer thinking it to be the patented buffer design.

(emphasis added) (JA334-JA335).

The Federal Circuit found fault with Ms. Eaton's declaration for three reasons. First, the court stated that "[t]he problem with Ms. Eaton's declaration is that she characterized the accused and patented designs as similar because they both have square cross sections and 'multiple' raised buffer pads, without directly acknowledging that the patented design has three pads while the accused design has four, one on each side." (App. 33a). With respect, that is incorrect. Ms. Eaton did directly acknowledge the difference in the amount of pads between the patented and accused designs. Further, she did so while properly keeping the comparative focus on the effect and appearance of the *whole* designs in a manner consistent with *Gorham*. She stated: "I understand that the accused nail buffer has one more buffer pad than the patented design. However, I do not believe that, to an ordinary observer and purchaser of nail buffers, the presence of one more buffer pad greatly alters the ornamental effect and appearance of the *whole design* as compared to the *whole patented design*." (emphasis added).

The court's second criticism was that Ms. Eaton "failed to address the fact that the design of the Nailco patent is identical to the accused device except that the Nailco design has three sides rather than four." (App. 33a). The Court continued "[t]hus, she could as easily

have said that the Nailco buffer design 'is like the accused design because both designs have a hollow tube, have multiple rectangular sides with raised rectangular pads mounted on each side that do not cover the corners of the tube,' in which case the Nailco prior art buffer would be seen to closely resemble the accused design." *Id.* The apparent point the Federal Circuit was making here is that if the accused design resembled the prior art more closely than the accused design resembled the patented design, then infringement did not exist under the practical comparative test. The problem with the Federal Circuit's analysis is that it violates the important principle that the visual effects of the *overall* designs are to be compared.

Under *Gorham*, it is not permissible to disregard certain portions of the design when making the comparison. However, that is precisely what the Federal Circuit did when the court eliminated the square versus triangular cross section from the comparison between the accused design and the Nailco design. (Note that in the Federal Circuit's "could as easily have said" statement above, any mention of the cross section is left out). It is respectfully submitted that neither Kathleen Eaton nor any other credible ordinary observer would *ever* agree that "the Nailco prior art buffer would be seen to closely resemble the accused design," for the reason that the Nailco buffer has a triangular cross section whereas the accused buffer has a square cross section. The *only* way such a conclusion ever can be achieved is by viewing the designs as something less than what they really are (by eliminating the cross section as the Federal Circuit

did). Such a comparison violates *Gorham*'s requirement of viewing and comparing designs as a whole.

The point can be clearly illustrated by: (1) substituting the Nailco Patent into Ms. Eaton's statement where she acknowledges the one pad difference between the patented and accused designs; and (2) by applying the Federal Circuit's analysis to the spoon designs in *Gorham*. When the Federal Circuit's analysis is applied to the *Gorham* designs, no infringement is found as a matter of law (whereas this Court found that infringement did exist).

First, consider substituting the Nailco Patent into Ms. Eaton's statement where she acknowledges the one pad difference between the patented and accused designs. Ms. Eaton states: "I understand that the accused nail buffer has one more buffer pad than the patented design. However, I do not believe that, to an ordinary observer and purchaser of nail buffers, the presence of one more buffer pad greatly alters the ornamental effect and appearance of the whole design as compared to the whole patented design." Substituting, the statement would read: "I understand that the accused nail buffer has a square cross section and the Nailco Buffer has a triangular cross section. However, I do not believe that, to an ordinary observer and purchaser of nail buffers, the difference in a triangular cross section versus a square cross section greatly alters the ornamental effect and appearance of the whole design as compared to the whole patented design." Ms. Eaton could never credibly have made such a statement because a triangle is fundamentally different in appearance than a square and changing the cross sectional shape of the buffer greatly alters the

ornamental effect and appearance of the whole design. The same analysis would hold true for the Falley buffer block because a hollow open ended buffer with raised pads (the accused buffer) is fundamentally different in overall appearance than a solid buffer block with pads that are not significantly raised (the Falley buffer block).

Before applying the Federal Circuit's interpretation of the *Gorham* test to the *Gorham* designs, it is helpful to study the Federal Circuit's legal analysis in *Egyptian Goddess*. The Federal Circuit first describes the similarities between the Nailco design and the accused design (hollow tube and multiple rectangular sides with raised rectangular pads mounted on each side that do not cover the corners of the tube), then disregards a major design difference (square v. triangular cross section), and concludes that the Nailco prior art buffer would be seen to closely resemble the accused design. (App. 33a). If this same analysis was used in *Gorham*, the result would be no infringement as a matter of law.

Although the prior art spoons are not described in *Gorham*, it should make no difference what the prior art spoons looked like. Under the Federal Circuit's analysis, the design similarities between the accused spoons and the prior art would be listed, the design differences would be ignored, and then the conclusion would be reached that the prior art spoons closely resemble the prior art. Then, as a result of viewing the designs as something less than a whole, the conclusion would be reached that since the accused design closely resembles the prior art (and by implication resembles the prior art more closely than the accused design

resembles the patented design), infringement does not exist.

Such a result would be contrary to this Court's holding in *Gorham* and would be reached only because important design elements (differences between the accused spoons and the prior art spoons) were disregarded in the comparison. This Court can prevent such an erroneous interpretation of *Gorham* and erroneous result by expressly requiring that the patented design, accused design, and prior art designs are to be compared with each other by considering the visual effects of the *whole designs*. As previously stated, the requirement of comparing the accused design as a whole with the prior art designs as a whole was not expressly set forth in *Gorham*, but it exists by necessary implication in light of the infringement finding in *Gorham* and the contrary result that would be achieved if the Federal Circuit's Egyptian Goddess analysis were applied to the *Gorham* spoon designs.

Further, and importantly, the effect of the Federal Circuit holding is that patented designs have no enforceable scope beyond their exact appearance. If a court can disregard the differences between the accused design and prior art designs when performing the three way practical test between the patented, accused, and prior art designs, then the court can always conclude that the accused design is similar enough to the prior art that no infringement exists (as was done in this case). The only time this cannot be done is when the accused design is exactly the same as the patented design and the accused design is not exactly the same as the prior art. Elimination of any enforceable claim scope beyond the exact patented

design is contrary to *Gorham* because this Court found infringement even though the accused spoon designs were not the same as the patented spoon design.

A third Federal Circuit criticism of the Eaton declaration was "nothing about Ms. Eaton's declaration explains why an ordinary observer would regard the accused design as being closer to the claimed design than to the Nailco prior art patent." (App. 33a). Ms. Eaton's omission is understandable because when the declaration was signed, the ordinary observer test as then interpreted by the Federal Circuit did not require asking whether the accused design was closer in overall appearance to prior art designs than it was to the patented design. If the Federal Circuit believed that such a declaration was necessary, the court could have remanded the case for further evidentiary development under the new test.

But with respect, the accused design is so obviously closer in overall appearance to the patented design than it is to the Nailco or Falley prior art buffer designs that another declaration is not necessary to deny summary judgment. The only difference between the patented and accused designs is one buffer pad, whereas the differences between the accused buffer and the prior art buffers are far greater. As mentioned above, and as is readily apparent from the buffer illustrations, the accused buffer is square in cross section whereas the Nailco buffer is triangular in cross section. Further, the accused design is hollow and has raised buffer pads whereas the Falley buffer block is solid and has relatively flat buffer pads. Given these differences, no ordinary observer can ever credibly conclude that the overall appearance of the accused

buffer is closer to the Nailco and Falley prior art buffers than it is to the patented design.

In sum, in light of the buffer illustrations, the only way the Federal Circuit could conclude that the accused buffer is just as close or closer to the Nailco prior art buffer than it is to the patented buffer design is by eliminating the cross section from consideration. As discussed, such an analysis violates *Gorham's* express and implicit requirements that the overall visual effects of the designs are to be compared. When the overall designs are compared, it is clear that the accused buffer is not closer in appearance to the prior art than it is to the patented design. Summary judgment of noninfringement therefore was improper.

A final point should be mentioned. One of the problems with the point of novelty test was that it allowed a point of novelty to be arbitrarily selected, which then determined the outcome of the infringement test. For example, in this case the district court arbitrarily selected a fourth side without a pad as the point of novelty and then granted summary judgment because the accused design did not have a fourth side without a pad.

The Federal Circuit's new and erroneous interpretation of the *Gorham* ordinary observer test suffers from the same type of flaw. If a court when comparing designs is allowed to eliminate the very design element that creates the substantial difference between the accused device and the prior art (in this case the cross section when comparing the accused design with the Nailco patent), then the test becomes arbitrary once again. The infringement outcome will be

determined by the design element that the court arbitrarily chooses to eliminate. This type of arbitrary analysis is contrary to *Gorham*.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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2006-1562

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

EGYPTIAN GODDESS, INC.,
Plaintiff-Appellant,
and ADI TORKIYA,
Third Party Defendant,
v.
SWISA, INC. and DROR SWISA,
Defendants/Third Party Plaintiffs-Appellees.

September 22, 2008, Decided

JUDGES: Before MICHEL, Chief Judge, and NEWMAN, ARCHER, MAYER, LOURIE, RADER, SCHALL, BRYSON, GAJARSA, LINN, DYK, PROST, and MOORE, Circuit Judges.

OPINION

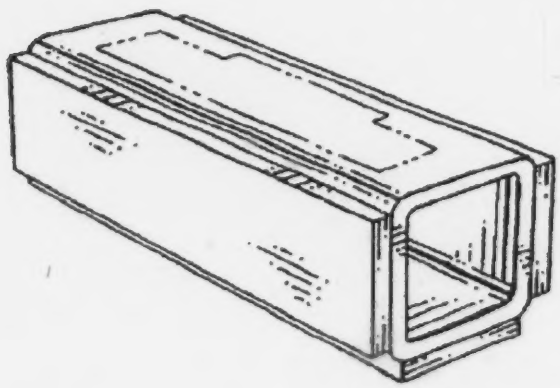
BRYSON, *Circuit Judge.*

We granted rehearing en banc in this design patent case to address the appropriate legal standard to be used in assessing claims of design patent infringement.

Appellant Egyptian Goddess, Inc., ("EGI") brought this action in the United States District Court for the Northern District of Texas, alleging that Swisa, Inc., and Dror Swisa (collectively, "Swisa") had infringed EGI's U.S. Design Patent No. 467,389 ("the '389 patent"). The patent claimed a design for a nail buffer, consisting of a rectangular, hollow tube having a

generally square cross-section and featuring buffer surfaces on three of its four sides. Swisa's accused product consists of a rectangular, hollow tube having a square cross-section, but featuring buffer surfaces on all four of its sides.

The district court first issued an order construing the claim of the '389 patent. In so doing, the district court sought to describe in words the design set forth in Figure 1 of the patent, which is depicted below:



Upon study of the claimed design, the court described it as follows:

> A hollow tubular frame of generally square cross section, where the square has sides of length S, the frame has a length of approximately 3S, and the frame has a thickness of approximately T = 0.1S, the corners of the cross section are rounded, with the outer corner of the cross section rounded on a 90 degree radius of approximately 1.25T, and the inner corner of the

> cross section rounded on a 90 degree radius of approximately 0.25T; and with rectangular abrasive pads of thickness T affixed to three of the sides of the frame, covering the flat portion of the sides while leaving the curved radius uncovered, with the fourth side of the frame bare.

In the same order, the district court ruled that "Swisa has not shown that the appearance of the Buffer Patent is dictated by its utilitarian purpose." The court therefore held that the patent is not invalid on the ground that the design was governed solely by function. *Egyptian Goddess, Inc. v. Swisa, Inc.*, Civil Action No. 3:03-CV-0594-N (N.D. Tex. Mar. 4, 2005), *citing Seiko Epson Corp. v. Nu-Kote Int'l, Inc.*, 190 F.3d 1360, 1368 (Fed. Cir. 1999).

Swisa then moved for summary judgment of noninfringement. The district court granted the motion. Citing 'precedent of this court, the district court stated that the plaintiff in a design patent case must prove both (1) that the accused device is "substantially similar" to the claimed design under what is referred to as the "ordinary observer" test, and (2) that the accused device contains "substantially the same points of novelty that distinguished the patented design from the prior art." *Egyptian Goddess, Inc. v. Swisa, Inc.*, Civil Action No. 3:03-CV-0594-N, 2005 U.S. Dist. LEXIS 32931 (N.D. Tex. Dec. 14, 2005), *citing Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113 (Fed. Cir. 1998). After comparing the claimed design and the accused product, the court held that Swisa's allegedly infringing product did not incorporate

the "point of novelty" of the '389 patent, which the court identified as "a fourth, bare side to the buffer."

The district court noted that the parties disagreed as to the points of novelty in the '389 patent. EGI identified four elements in its design, and for each element it identified prior art that did not embody that element. EGI therefore contended that the point of novelty of the '389 patent is the combination of those four elements. The district court, however, declined to address the question whether the point of novelty could be found in the combination of elements not present in various prior art references, because the court found that a single prior art reference, United States Design Patent No. 416,648 ("the Nailco patent"), contained all but one of the elements of the '389 design. The court described the Nailco Patent as disclosing "a nail buffer with an open and hollow body, raised rectangular pads, and open corners." The only element of the '389 patent design that was not present in the Nailco patent, according to the district court, was "the addition of the fourth side without a pad, thereby transforming the equilateral triangular cross-section into a square." Because the Swisa product does not incorporate the point of novelty of the '389 patent--a fourth side without a pad--the court concluded that there was no infringement.

EGI appealed, and a panel of this court affirmed. The panel agreed with the district court that there was no issue of material fact as to whether the accused Swisa buffer "appropriates the point of novelty of the claimed design." *Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F.3d 1354, 1355 (Fed. Cir. 2007). In reaching that conclusion, the panel stated that the point of novelty in a patented

design "can be either a single novel design element or a combination of elements that are individually known in the prior art." *Id.* at 1357. The panel added, however, that in order for a combination of individually known design elements to constitute a point of novelty, "the combination must be a non-trivial advance over the prior art." *Id.*

The panel noted that EGI's asserted point of novelty was a combination of four of the claimed design's elements: (1) an open and hollow body, (2) a square cross-section, (3) raised rectangular buffer pads, and (4) exposed corners. The panel agreed with the district court's observation that the Nailco prior art patent contained each of those elements except that the body was triangular, rather than square, in cross-section. 498 F.3d at 1358. In light of the prior art, the panel determined that "no reasonable juror could conclude that EGI's asserted point of novelty constituted a non-trivial advance over the prior art." *Id.*

The panel further observed that the various design elements of the claimed design "were each individually disclosed in the prior art." 498 F.3d at 1358. The Swisa buffers, the panel noted, have raised, abrasive pads on all four sides, not just on three of the four sides, as in the claimed design, in which the fourth side is bare. The panel then concluded that "[w]hen considering the prior art in the nail buffer field, this difference between the accused design and the patented design cannot be considered minor." *Id.* The panel therefore concluded that summary judgment was appropriate.

The dissenting judge would not have adopted the "non-trivial advance" test as a way of ascertaining whether a

particular feature of the claimed design constituted a point of novelty for infringement purposes. In the view of the dissenting judge, the "non-trivial advance" test was inconsistent with and unsupported by prior precedent; it conflated the criteria for infringement and obviousness; it applied only to designs that involved combinations of design elements; and it improperly focused on the obviousness of each point of novelty, rather than the obviousness of the overall design. 498 F.3d at 1359-60 (Dyk, J., dissenting).

This court granted rehearing en banc and asked the parties to address several questions, including whether the "point of novelty" test should continue to be used as a test for infringement of a design patent; whether the court should adopt the "non-trivial advance test" as a means of determining whether a particular design feature qualifies as a point of novelty; how the point of novelty test should be administered, particularly when numerous features of the design differ from certain prior art designs; and whether district courts should perform formal claim construction in design patent cases.

I

The starting point for any discussion of the law of design patents is the Supreme Court's decision in *Gorham Co. v. White*, 81 U.S. 511, 20 L. Ed. 731 (1871). That case involved a design patent for the handles of tablespoons and forks. In its analysis of claim infringement, the Court stated that the test of identity of design "must be sameness of appearance, and mere difference of lines in the drawing or sketch . . . or slight variances in configuration . . . will not destroy the

substantial identity." *Id.* at 526-27. Identity of appearance, the Court explained, or "sameness of effect upon the eye, is the main test of substantial identity of design"; the two need not be the same "to the eye of an expert," because if that were the test, "[t]here never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another, so like, that an expert could not distinguish them." *Id.* at 527.

The *Gorham* Court then set forth the test that has been cited in many subsequent cases: "[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other." 81 U.S. at 528. In the case before it, the Court concluded that "whatever differences there may be between the plaintiffs' design and those of the defendant in details of ornament, they are still the same in general appearance and effect, so much alike that in the market and with purchasers they would pass for the same thing--so much alike that even persons in the trade would be in danger of being deceived." *Id.* at 531.

Since the decision in *Gorham*, the test articulated by the Court in that case has been referred to as the "ordinary observer" test and has been recognized by lower courts, including both of this court's predecessors, as the proper standard for determining design patent infringement. *See, e.g., Blumcraft of Pittsburgh v. United States*, 372 F.2d 1014, 1016, 178 Ct. Cl. 798 (Ct. Cl. 1967); *In re Dubois*, 262 F.2d 88, 91, 46 C.C.P.A. 744, 1959 Dec. Comm'r Pat. 164 (CCPA 1958).

However, in a series of cases tracing their origins to *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984), this court has held that proof of similarity under the ordinary observer test is not enough to establish design patent infringement. Rather, the court has stated that the accused design must also appropriate the novelty of the claimed design in order to be deemed infringing. The court in *Litton Systems* wrote as follows:

> For a design patent to be infringed . . . no matter how similar two items look, "the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art." That is, even though the court compares two items through the eyes of the ordinary observer, it must nevertheless, to find infringement, attribute their similarity to the novelty which distinguishes the patented device from the prior art.

Litton Systems, 728 F.2d at 1444 (citations omitted). After identifying the combination of features in the design that it considered novel, the court in *Litton Systems* held that the accused design had none of those features and therefore did not infringe. *Id.*

In a number of cases decided after *Litton Systems*, this court has interpreted the language quoted above to require that the test for design patent infringement consider both the perspective of the ordinary observer and the particular novelty in the claimed design. *See, e.g., Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1383 (Fed. Cir. 2004); *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1377 (Fed.

Cir. 2002); *Unidynamics Corp. v. Automatic Prods. Int'l Inc.*, 157 F.3d 1311, 1323-24 (Fed. Cir. 1998); *Oakley, Inc. v. Int'l Tropic-Cal., Inc.*, 923 F.2d 167, 169 (Fed. Cir. 1991); *Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557, 1565 (Fed. Cir. 1988).

The extent to which the point of novelty test has been a separate test has not always been clear in this court's case law. In cases decided shortly after *Litton*, the court described the ordinary observer test and the point of novelty test as "conjunctive." *See L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1125 (Fed. Cir. 1993); *Shelcore, Inc. v. Durham Indus., Inc.*, 745 F.2d 621, 628 n.16 (Fed. Cir. 1984). It has not been until much more recently that this court has described the ordinary observer and point of novelty tests as "two distinct tests" and has stated that "[t]he merger of the point of novelty test and the ordinary observer test is legal error." *Unidynamics Corp.*, 157 F.3d at 1323-24; *see also Lawman Armor Corp.* v. Winner Int'l, LLC, 437 F.3d 1383, 1384 (Fed. Cir. 2006); *Contessa Food Prods.*, Inc., 282 F.3d at 1377; *Sun Hill Indus., Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1197 (Fed. Cir. 1995).

Regardless of the differences in the way it has been characterized, the point of novelty test has proved reasonably easy to apply in simple cases in which the claimed design is based on a single prior art reference and departs from that reference in a single respect. In such cases, it is a simple matter to identify the point of novelty and to determine whether the accused design has appropriated the point of novelty, as opposed to copying those aspects of the claimed design that were already in the prior art. However, the point of novelty

test has proved more difficult to apply where the claimed design has numerous features that can be considered points of novelty, or where multiple prior art references are in issue and the claimed design consists of a combination of features, each of which could be found in one or more of the prior art designs. In particular, applying the point of novelty test where multiple features and multiple prior art references are in play has led to disagreement over whether combinations of features, or the overall appearance of a design, can constitute the point of novelty of the claimed design. *Compare Lawman Armor Corp. v. Winner Int'l LLC*, 449 F.3d 1190 (Fed. Cir. 2006) (supplemental opinion on petition for rehearing), *with Lawman Armor Corp. v. Winner Int'l, LLC*, 449 F.3d 1192 (Fed. Cir. 2006) (Newman, J., dissenting from denial of rehearing en banc). In light of the questions surrounding the status and application of the point of novelty test, we use this case as a vehicle for reconsidering the place of the point of novelty test in design patent law generally.

II

EGI argues that this court should no longer recognize the point of novelty test as a second part of the test for design patent infringement, distinct from the ordinary observer test established in *Gorham*. Instead of requiring the fact-finder to identify one or more points of novelty in the patented design and then determining whether the accused design has appropriated some or all of those points of novelty, EGI contends that the ordinary observer test can fulfill the purposes for which the point of novelty test was designed, but with less risk of confusion. As long as the ordinary observer test

focuses on the "appearance that distinguishes the patented design from the prior art," EGI contends that it will enable the fact-finder to address the proper inquiry, i.e., whether an ordinary observer, familiar with the prior art, would be deceived into thinking that the accused design was the same as the patented design. Relatedly, EGI argues that if the ordinary observer test is performed from the perspective of an ordinary observer who is familiar with the prior art, there is no need for a separate "non-trivial advance" test, because the attention of an ordinary observer familiar with prior art designs will naturally be drawn to the features of the claimed and accused designs that render them distinct from the prior art.

Several of the amici make essentially the same point, referring to the proper approach as calling for a three-way visual comparison between the patented design, the accused design, and the closest prior art. The amici point out that courts, including this one, have on occasion applied that approach in design patent cases, without identifying it as a separate test. *See, e.g.*, Brief of Amicus Curiae Apple, Inc., at 19 (*citing, inter alia, Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir., 1995); *Braun, Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815 (Fed Cir. 1992); and *Bergstrom v. Sears, Roebuck & Co.*, 496 F. Supp. 476 (D. Minn. 1980)).

Swisa counters that this court may not, and should not, abandon the point of novelty test. According to Swisa, the point of novelty test was adopted by the Supreme Court in *Smith v. Whitman Saddle Co.*, 148 U.S. 674, 13 S. Ct. 768, 37 L. Ed. 606, 1893 Dec. Comm'r Pat. 324 (1893). Swisa interprets that case as dictating the use of the point of novelty test as a second and distinct test for

design patent infringement, separate from the ordinary observer test set forth in *Gorham*. Swisa contends that the subsequent decisions of this court and others applying the point of novelty test are soundly based on *Whitman Saddle*, and that we cannot depart from that test without disregarding that governing Supreme Court precedent as well as intervening precedent from other courts of appeals.

We disagree with Swisa's submission. A close reading of *Whitman Saddle* and subsequent authorities indicates that the Supreme Court did not adopt a separate point of novelty test for design patent infringement cases. In fact, a study of the development of design patent law in the years after *Gorham* shows that the point of novelty test, in its current form, is of quite recent vintage. After a review of those authorities, which we examine in some detail below, we conclude that the point of novelty test, as a second and free-standing requirement for proof of design patent infringement, is inconsistent with the ordinary observer test laid down in *Gorham*, is not mandated by *Whitman Saddle* or precedent from other courts, and is not needed to protect against unduly broad assertions of design patent rights.

Whitman Saddle involved a patent on a design for a saddle. The Court began by reciting the requirements for obtaining patent protection for a design. The Court emphasized the importance of "invention" to the patentability of a design. It stated, "Mere mechanical skill is insufficient. There must be something akin to genius, an effort of the brain as well as the hand. The adaptation of old devices or forms to new purposes, however convenient, useful, or beautiful they may be in

their new role, is not invention." 148 U.S. at 679. The Court then explained (*id.*):

> The exercise of the inventive or originative faculty is required, and a person cannot be permitted to select an existing form, and simply put it to a new use, any more than he can be permitted to take a patent for the mere double use of a machine. If, however, the selection and adaptation of an existing form is more than the exercise of the imitative faculty, and the result is in effect a new creation, the design may be patentable.

In the case before it, the Court characterized the patented saddle design as a combination of elements from two saddle designs that were well known in the art. The Court explained that the patented design consisted of a combination of the front half of the so-called Granger saddle and the back end of the so-called Jenifer saddle. The design differed from a simple combination of the two known saddles, according to the Court, only in that the front end of the design had "a nearly perpendicular drop of some inches at the rear of the pommel," unlike in the Granger saddle. *Id.* at 680.

Although the trial court, sitting in equity, concluded that the design was patentable, the Supreme Court disagreed. The Court wrote, "Nothing more was done in this instance (except as hereafter noted) than to put the two halves of these saddles together in the exercise of the ordinary skill of workmen of the trade, and in the way and manner ordinarily done." 148 U.S. at 681. The Court noted that there was a difference between the pommel of the designed saddle and the pommel of the

Granger saddle, and it added that the "shape of the front end being old, the sharp drop of the pommel at the rear seems to constitute what was new and to be material." *Id.* at 682. That feature, however, was not present in the defendants' saddle. The Court then concluded with the following remarks (*id.*):

> If, therefore, this drop were material to the design, and rendered it patentable as a complete and integral whole, there was no infringement. As before said, the design of the patent had two features of difference as compared with the Granger saddle, one the cantle, the other the drop; and, unless there was infringement as to the latter there was none at all, since the saddle design of the patent does not otherwise differ from the old saddle with the old cantle added, an addition frequently made. Moreover, that difference was so marked that in our judgment the defendant's saddle could not be mistaken for the saddle of the complainant.

Because *Whitman Saddle* was an action in equity, the Court did not distinguish sharply between its analysis of patentability and its discussion of infringement. Within the same passage, the Court moved from stating that it could not agree with the trial court that the design in issue was patentable to the conclusion that if the design were patentable because of the drop at the rear of the pommel, there was no infringement. Nothing in the Court's opinion suggested that it was fashioning a separate point of novelty test for infringement. The point the Court was making was that, viewed in light of the similarities between the prior art and the patented design, the accused design

did not contain the single feature that would have made it appear distinctively similar to the patented design rather than like the numerous prior art designs. For that reason, the Court held, the accused design did not infringe.

Subsequent cases applied that principle, interpreting the ordinary observer test of *Gorham* to require that the perspective of the ordinary observer be informed by a comparison of the patented design and the accused design in light of the prior art, so as to enable the fact-finder to determine whether the accused design had appropriated the inventiveness of the patented design. For example, two cases decided in the wake of *Whitman Saddle* shed light on the Supreme Court's analysis in *Whitman Saddle* and illustrate the application of the ordinary observer test in light of the prior art.

In the first of those cases, *Bevin Brothers Manufacturing Co. v. Starr Brothers Bell Co.*, 114 F. 362 (C.C.D. Conn. 1902), the patent drawing showed an oblate spheroid and neck, and the claim covered "a bell as herein shown and described." Sitting in equity, the court addressed both validity and infringement, noting that the test of identity on both issues "is the eye of the ordinary observer." *Id.* at 363. After noting that the patented form was commonly found in a variety of prior art structures, the court held that the "defense of want of patentable novelty is sustained." *Id.* As for infringement, the court again consulted particular objects in the prior art having a similar shape, including a door knob, and concluded that "[t]he shape of the defendant's bell differs from plaintiff's more widely than plaintiff's differs from the door knob, and

therefore defendants' construction does not infringe the patent." *Id.* Thus, the court's approach, like that of the Supreme Court in *Whitman Saddle,* did not employ a point of novelty test, but invoked the ordinary observer test in which the observer was comparing the patented and accused designs in the context of similar designs found in the prior art

The second case, *Zidell v. Dexter,* 262 F. 145 (9th Cir. 1920), cited *Whitman Saddle* for the proposition that under the ordinary observer standard, a patented design that consists "only of bringing together old elements with slight modifications of form" is not infringed by "another who uses the same elements with his own variations of form . . . if his design is distinguishable by the ordinary observer from the patented design." *Id.* at 146. The court emphasized the importance of similar prior art designs to the determination of infringement under the ordinary observer test:

> The evidence shows that at and prior to the conception of this design there were in use and on sale very many similar garments, with variations in design so slight as to leave to the ordinary observer the impression of a very general resemblance, and we must assume that to womankind, who are the purchasers in the main of this class of garment, these various coincident forms of garments were known, and whether such purchasers would be deceived into taking the garments which are alleged to infringe for a garment of the patented design would necessarily depend largely upon that general knowledge.

Id. at 147.

Some years later, the Sixth Circuit addressed a similar issue in a case involving a design patent on a combination ash tray and electric lighter. *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428 (6th Cir. 1933). The district court found infringement by two of the defendant's designs upon finding that the resemblance between the patented design and the accused design was such as to deceive the ordinary observer. In analyzing the case, the court addressed the question whether the ordinary observer test of *Gorham* was in conflict with the principle that "similitude of appearance is to be judged by the scope of the patent in relation to the prior art." *Id.* at 429.

The court explained that the ordinary observer of the *Gorham* test was not one "who has never seen an ash tray or a cigar lighter, but one who, though not an expert, has reasonable familiarity with such objects," and is capable of assessing the similarity of the patented and accused designs in light of the similar objects in the prior art. 67 F.2d at 430. Viewing the ordinary observer test in that manner, the court stated:

> [W]hile there is some similarity between the patented and alleged infringing designs, which without consideration of the prior art might seem important, yet such similarity as is due to common external configuration is no greater, if as great, between the patented and challenged designs as between the former and the designs of the prior art.

Id. After noting the similarities between the patented design and the prior art designs, the court concluded that the differences between the two "are no greater than those that exist between the patented design and the alleged infringing designs." Accordingly, the court concluded, assuming the patent to be valid "it is quite clear it is entitled to a very limited interpretation and that so limited the defendant's designs do not infringe." *Id.* The court ruled that while it was aware that similarity "is not to be determined by making too close an analysis of detail," nonetheless, "where in a crowded art the composite of differences presents a different impression to the eye of the average observer (as above defined), infringement will not be found."

Id. That precedent was followed by the Eighth Circuit in *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395 (8th Cir. 1944). The district court in that case held that the defendant's home fruit juicer infringed the plaintiff's patents on fruit juicer designs. The court stated that the test for design patent infringement involves two elements: (1) "the identity of appearance, or sameness of effect as a whole upon the eye of an ordinary purchaser must be such as to deceive him, inducing him to purchase one, supposing it to be the other" and (2) "the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art." *Id.* at 395-96. To make the latter determination, the court explained, "requires a comparison of the features of the patented designs with the prior art and with the accused design." *Id.* at 396. By examining the prior art fruit juicers, the court was able to identify the "novel elements embodied in the [patented] design." The court then determined that there was no identity of

appearance with respect to those elements between the claimed designs and the accused products. *Id.*

The *Sears, Roebuck* and *Applied Arts* cases, in turn, became the principal precedents relied upon by this court in the seminal *Litton Systems* case to which this court's precedents dealing with the point of novelty test trace their origin. In *Litton Systems*, as in *Sears, Roebuck*, the court identified the *Gorham* ordinary observer test as the starting point for design patent infringement. Quoting from *Sears, Roebuck*, the *Litton* court added, however, that "no matter how similar two items look, 'the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.'" 728 F.2d at 1444. That is, the court added, after comparing two items through the eyes of the ordinary observer, the court must, to find infringement, "attribute their similarity to the novelty which distinguishes the patented device from the prior art." *Id.* The court then referred to that second test as the point of novelty approach, and that tag has been applied to the second part of the design patent infringement test ever since.

In analyzing the claim of infringement, the court in *Litton Systems* focused on what it characterized as the novelty of the patent in suit, i.e., "the combination on a microwave oven's exterior of a three-stripe door frame, a door without a handle, and a latch release lever on the control panel." Significantly, however, the court quoted from the *Applied Arts* case and stated that the degree of similarity between the accused design and the patented design had to be assessed in light of the designs in the prior art. The court noted that where, as in the case before it, "a field is crowded with many

references relating to the design of the same type of appliance, we must construe the range of equivalents very narrowly." 728 F.2d at 1444. Accordingly, the court held that the scope of protection of the patent in that case was limited to "a narrow range" that did not include the accused design. *Id.*

As noted, this court has cited *Litton Systems* for the proposition that the point of novelty test is separate from the ordinary observer test and requires the patentee to point out the point of novelty in the claimed design that has been appropriated by the accused design. We think, however, that Litton and the predecessor cases on which it relied are more properly read as applying a version of the ordinary observer test in which the ordinary observer is deemed to view the differences between the patented design and the accused product in the context of the prior art. When the differences between the claimed and accused design are viewed in light of the prior art, the attention of the hypothetical ordinary observer will be drawn to those aspects of the claimed design that differ from the prior art. And when the claimed design is close to the prior art designs, small differences between the accused design and the claimed design are likely to be important to the eye of the hypothetical ordinary observer. It was for that reason that the Supreme Court in *Whitman Saddle* focused on the one feature of the patented saddle design that departed from the prior art--the sharp drop at the rear of the pommel. To an observer familiar with the multitude of prior art saddle designs, including the design incorporating the Granger pommel and the Jenifer cantle, "an addition frequently made," 148 U.S. at 682, the sharp drop at the rear of the pommel would be important to the overall appearance

of the design and would serve to distinguish the accused design, which did not possess that feature, from the claimed design.

The same can be said of the courts' analysis in *Bevin Brothers*, *Zidell*, *Applied Arts*, and *Sears, Roebuck*. In *Bevin Brothers* and *Zidell*, the courts emphasized that the defendant's product would appear different from the plaintiff's protected design to an ordinary observer aware of the great number of closely similar prior art designs. In *Applied Arts*, the accused ash tray would not appear to be the same as the claimed ash tray as long as "similitude of appearance is . . . judged by the scope of the patent in relation to the prior art." 67 F.2d at 429. And in *Sears, Roebuck*, the court concluded that the accused fruit juicer would not appear similar to the claimed design if the fact-finder performed the required "comparison of the features of the patented designs with the prior art and with the accused design." 140 F.2d at 396.

Not only is this approach consistent with the precedents discussed above, but it makes sense as a matter of logic as well. Particularly in close cases, it can be difficult to answer the question whether one thing is like another without being given a frame of reference. The context in which the claimed and accused designs are compared, i.e., the background prior art, provides such a frame of reference and is therefore often useful in the process of comparison. Where the frame of reference consists of numerous similar prior art designs, those designs can highlight the distinctions between the claimed design and the accused design as viewed by the ordinary observer.

Applying the ordinary observer test with reference to prior art designs also avoids some of the problems created by the separate point of novelty test. One such problem is that the point of novelty test has proved difficult to apply in cases in which there are several different features that can be argued to be points of novelty in the claimed design. In such cases, the outcome of the case can turn on which of the several candidate points of novelty the court or fact-finder focuses on. The attention of the court may therefore be focused on whether the accused design has appropriated a single specified feature of the claimed design, rather than on the proper inquiry, i.e., whether the accused design has appropriated the claimed design as a whole. *See Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365, 1370-71 (Fed. Cir. 2006); *Keystone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1450 (Fed. Cir. 1993); *Braun Inc.*, 975 F.2d at 820.

In addition, the more novel the design, and the more points of novelty that are identified, the more opportunities there are for a defendant to argue that its design does not infringe because it does not copy all of the points of novelty, even though it may copy most of them and even though it may give the overall appearance of being identical to the claimed design. In such cases, a test that asks how an ordinary observer with knowledge of the prior art designs would view the differences between the claimed and accused designs is likely to produce results more in line with the purposes of design patent protection.

This court has characterized the purpose of the point of novelty test as being "to focus on those aspects of a

design which render the design different from prior art designs." *Sun Hill Indus., Inc.*, 48 F.3d at 1197, quoting *Winner Int'l Corp. v. Wolo Mfg. Corp.*, 905 F.2d 375, 376 (Fed. Cir. 1990). That purpose can be equally well served, however, by applying the ordinary observer test through the eyes of an observer familiar with the prior art. If the accused design has copied a particular feature of the claimed design that departs conspicuously from the prior art, the accused design is naturally more likely to be regarded as deceptively similar to the claimed design, and thus infringing. At the same time, unlike the point of novelty test, the ordinary observer test does not present the risk of assigning exaggerated importance to small differences between the claimed and accused designs relating to an insignificant feature simply because that feature can be characterized as a point of novelty.

This approach also has the advantage of avoiding the debate over the extent to which a combination of old design features can serve as a point of novelty under the point of novelty test. An ordinary observer, comparing the claimed and accused designs in light of the prior art, will attach importance to differences between the claimed design and the prior art depending on the overall effect of those differences on the design. If the claimed design consists of a combination of old features that creates an appearance deceptively similar to the accused design, even to an observer familiar with similar prior art designs, a finding of infringement would be justified. Otherwise, infringement would not be found.

One function that has been served by the point of novelty test, according to Swisa and its supporting

amid, is to cabin unduly broad assertions of design patent scope by ensuring that a design that merely embodies or is substantially similar to prior art designs is not found to infringe. Again, however, we believe that the preferable way to achieve that purpose is to do so directly, by relying on the ordinary observer test, conducted in light of the prior art. Our rejection of the point of novelty test does not mean, of course, that the differences between the claimed design and prior art designs are irrelevant. To the contrary, examining the novel features of the claimed design can be an important component of the comparison of the claimed design with the accused design and the prior art. But the comparison of the designs, including the examination of any novel features, must be conducted as part of the ordinary observer test, not as part of a separate test focusing on particular points of novelty that are designated only in the course of litigation.

On the basis of the foregoing analysis, we hold that the "point of novelty" test should no longer be used in the analysis of a claim of design patent infringement. Because we reject the "point of novelty" test, we also do not adopt the "non-trivial advance" test, which is a refinement of the "point of novelty" test. Instead, in accordance with *Gorham* and subsequent decisions, we hold that the "ordinary observer" test should be the sole test for determining whether a design patent has been infringed. Under that test, as this court has sometimes described it, infringement will not be found unless the accused article "embod[ies] the patented design or any colorable imitation thereof." *Goodyear Tire & Rubber Co.*, 162 F.3d at 1116-17; *see also Arminiak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1319 (Fed. Cir. 2007).

In some instances, the claimed design and the accused design will be sufficiently distinct that it will be dear without more that the patentee has not met its burden of proving the two designs would appear "substantially the same" to the ordinary observer, as required by *Gorham.* In other instances, when the claimed and accused designs are not plainly dissimilar, resolution of the question whether the ordinary observer would consider the two designs to be substantially the same will benefit from a comparison of the claimed and accused designs with the prior art, as in many of the cases discussed above and in the case at bar. Where there are many examples of similar prior art designs, as in a case such as *Whitman Saddle,* differences between the claimed and accused designs that might not be noticeable in the abstract can become significant to the hypothetical ordinary observer who is conversant with the prior art.

We emphasize that although the approach we adopt will frequently involve comparisons between the claimed design and the prior art, it is not a test for determining validity, but is designed solely as a test of infringement. Thus, as is always the case, the burden of proof as to infringement remains on the patentee. However, if the accused infringer elects to rely on the comparison prior art as part of its defense against the claim of infringement, the burden of production of that prior art is on the accused infringer. To be sure, we have stated that the burden to introduce prior art under the point of novelty test falls on the patentee. *See Bernhardt,* 386 F.3d at 1384. Under the ordinary observer test, however, it makes sense to impose the burden of production as to any comparison prior art on the accused infringer. The accused infringer is the party

with the motivation to point out close prior art, and in particular to call to the court's attention the prior art that an ordinary observer is most likely to regard as highlighting the differences between the claimed and accused design. Regardless of whether the accused infringer elects to present prior art that it considers pertinent to the comparison between the claimed and accused design, however, the patentee bears the ultimate burden of proof to demonstrate infringement by a preponderance of the evidence. As in our recent decision in *In re Seagate Technology, LLC*, we "leave it to future cases to further develop the application of this standard." 497 F.3d 1360, 1371 (Fed. Cir. 2007) (en banc).

III

One of the issues raised by this court in its order granting en banc review was whether trial courts should conduct claim construction in design patent cases. While this court has held that trial courts have a duty to conduct claim construction in design patent cases, as in utility patent cases, *see Elmer*, 67 F.3d at 1577, the court has not prescribed any particular form that the claim construction must take. To the contrary, the court has recognized that design patents "typically are claimed as shown in drawings," and that claim construction "is adapted accordingly." *Arminiak & Assocs., Inc.*, 501 F.3d at 1319; *see also Goodyear Tire & Rubber Co.*, 162 F.3d at 1116. For that reason, this court has not required that the trial court attempt to provide a detailed verbal description of the claimed design, as is typically done in the case of utility patents. *See Contessa Food Prods., Inc.*, 282 F.3d at 1377 (approving district court's construction of the asserted

claim as meaning "a tray of a certain design as shown in Figures 1-3").[1]

As the Supreme Court has recognized, a design is better represented by an illustration "than it could be by any description and a description would probably not be intelligible without the illustration." *Dobson v. Dornan*, 118 U.S. 10, 14, 6 S. Ct. 946, 30 L. Ed. 63, 1886 Dec. Comm'r Pat. 202 (1886). The Patent and Trademark Office has made the same observation. *Manual of Patent Examining Procedure* § 1503.01 (8th ed. 2006) ("[A]s a rule the illustration in the drawing views is its own best description."). Given the recognized difficulties entailed in trying to describe a design in words, the preferable course ordinarily will be for a district court not to attempt to "construe" a design patent claim by providing a detailed verbal description of the claimed design.

With that said, it is important to emphasize that a district court's decision regarding the level of detail to be used in describing the claimed design is a matter within the court's discretion, and absent a showing of prejudice, the court's decision to issue a relatively detailed claim construction will not be reversible error. At the same time, it should be clear that the court is not obligated to issue a detailed verbal description of the design if it does not regard verbal elaboration as necessary or helpful. In addition, in deciding whether to attempt a verbal description of the claimed design, the court should recognize the risks entailed in such a description, such as the risk of placing undue emphasis on particular features of the design and the risk that a finder of fact will focus on each individual described feature in the verbal description rather than on the

design as a whole. In this case, for example, the district court came up with a detailed verbal description of the claimed design. We see no inaccuracy in the court's description, and neither party has pointed to any prejudice resulting from the court's interpretation. Yet it is not clear that the considerable effort needed to fashion the verbal description contributed enough to the process of analyzing the case to justify the effort.

While it may be unwise to attempt a full description of the claimed design, a court may find it helpful to point out, either for a jury or in the case of a bench trial by way of describing the court's own analysis, various features of the claimed design as they relate to the accused design and the prior art. In a case such as this one, for example, there would be nothing wrong with the court pointing out to a jury that in the patented design only three sides have buffers attached, while in the accused product (and in the three-sided Nailco patent), all of the sides have buffers attached. It would similarly be permissible for the court to point out that, for example, although the FaIley Buffer Block has four sides, it is not hollow, unlike the design of the '389 patent, the Nailco patent, and the accused Swisa product.

Apart from attempting to provide a verbal description of the design, a trial court can usefully guide the finder of fact by addressing a number of other issues that bear on the scope of the claim. Those include such matters as describing the role of particular conventions in design patent drafting, such as the role of broken lines, *see* 37 C.F.R. § 1.152; assessing and describing the effect of any representations that may have been made in the course of the prosecution history, *see Goodyear Tire &*

Rubber Co., 162 F.3d at 1116; and distinguishing between those features of the claimed design that are ornamental and those that are purely functional, *see Oddzon Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) ("Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.").

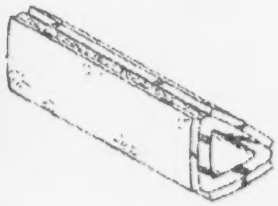
Providing an appropriate measure of guidance to a jury without crossing the line and unduly invading the jury's fact-finding process is a task that trial courts are very much accustomed to, and any attempt by an appellate court to guide that process in detail is likely to do more harm than good. We therefore leave the question of verbal characterization of the claimed designs to the discretion of trial judges, with the proviso that as a general matter, those courts should not treat the process of claim construction as requiring a detailed verbal description of the claimed design, as would typically be true in the case of utility patents.

IV

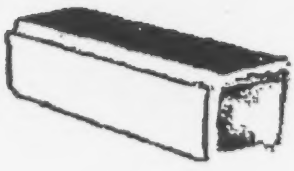
We now turn to the facts of this case. It is agreed that the general shape of the accused nail buffer at issue in this case is the same as that of the patented buffer design. The difference between the two is that the accused buffer has raised buffing pads on all four sides, while the patented buffer has buffing pads on only three sides. The two closest prior art nail buffers before the court were the Falley nail buffer, which has a solid, rectangular cross section with slightly raised buffers on all sides, and the Nailco patent, which shows a nail

buffer design having a triangular shape and a hollow cross section, and in which raised buffing pads are located on all three sides. The four nail buffers are pictured below:

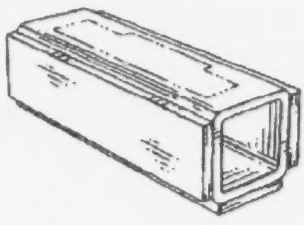
Falley Buffer Block



Nailco Patent



Swisa Buffer



'389 patent

The question before this court under the standard we have set forth above is whether an ordinary observer, familiar with the prior art Falley and Nailco designs, would be deceived into believing the Swisa buffer is the same as the patented buffer. EGI argues that such an observer would notice a difference between the prior art and the '389 patent, consisting of "the hollow tube that is square in cross section and that has raised pads with exposed gaps at the corners." To support that contention, EGI invokes the declaration of its expert

witness, Kathleen Eaton. After viewing the patented, accused, and Nailco buffers, Ms. Eaton concluded that the patented and accused designs would "confuse an ordinary observer into purchasing the accused buffer thinking it to be the patented buffer design." She reached that conclusion, she explained, because "the substantially similar appearance [between the accused and patented designs] results from both designs having a hollow tube, square in cross section and rectangular in length, with multiple raised rectangular pads mounted on the sides, and that do not cover the corners of the tube." While recognizing that the accused buffer has pads on all four sides and that the claimed design has buffer pads on only three sides, she stated that "I do not believe that, to an ordinary observer and purchaser of nail buffers, the presence of one more buffer pad[s] greatly alters the ornamental effect and appearance of the whole design as compared to the whole patented design."

Swisa counters that the '389 patent closely tracks the design of the Nailco nail buffer, except that it "add[s] a fourth side without an abrasive pad, resulting in square ends." In light of the close prior art buffers, including a number having square cross-sections, Swisa argues that an ordinary observer would notice the difference between the claimed and accused designs. To support that contention, Swisa cites the declaration of its expert, Steve Falley. Mr. Falley addressed the differences among the prior art designs, the accused design, and patented design, and he concluded that

> you could simply add to the Nailco Buffer a fourth side without an abrasive on it. This merely takes the Nailco Buffer to the block

> shape of the original Falley Buffer Block, while keeping the hollow aspect of the Nailco Buffer. As there had already been on the market for a long time 3-way buffer blocks that had no abrasive on one side, it was also obvious after the Nailco Buffer that you could have a three way hollow buffer that had four sides but with no abrasive on one side.

Mr. Falley added that "four-way" nail buffers having four different abrasive surfaces have been made since 1985, and that four-sided "buffer blocks" have been on the market since 1987. He pointed to catalogs showing three-sided and four-sided buffer blocks that have been offered for sale since at least 1994, and in light of his knowledge of the industry, he stated that the "number of sides with abrasive surface on them would be important to purchasers because it determines whether a buffer is a "three way buffer" or a "four way buffer." Accordingly, he concluded:

> The difference between a buffer with abrasive on three sides--a "three-way buffer"--and a buffer with abrasive on four sides--a "four-way buffer"--is immediately apparent to any consumer used to buying nail buffers. Even if such a consumer did not have a preference for either three-way or four-way buffers (although they almost always do), they would at a glance be able to tell that a buffer with abrasive on only three sides had abrasive on three sides, and was a three-way buffer, while a buffer with abrasive on four sides had abrasive on all four sides, and was a four-way buffer. I cannot imagine consumers would buy buffers with abrasive on four sides thinking

> that they were buying buffers with abrasive on three sides.

The problem with Ms. Eaton's declaration is that she characterized the accused and patented designs as similar because they both have square cross sections and "multiple" raised buffer pads, without directly acknowledging that the patented design has three pads while the accused design has four, one on each side. She also failed to address the fact that the design of the Nailco patent is identical to the accused device except that the Nailco design has three sides rather than four. Thus, she could as easily have said that the Nailco buffer design "is like the accused design because both designs have a hollow tube, have multiple rectangular sides with raised rectangular pads mounted on each side that do not cover the corners of the tube," in which case the Nailco prior art buffer would be seen to closely resemble the accused design. Nothing about Ms. Eaton's declaration explains why an ordinary observer would regard the accused design as being closer to the claimed design than to the Nailco prior art patent. In fact, Ms. Eaton's reference to the prior art buffers is limited to the single, and conclusory, comment that an ordinary observer and purchaser of nail buffers would consider the patented design and the accused buffer to be substantially similar, "particularly in light of other nail buffers, such as a solid block buffer and the hollow triangular Nailco buffer."

In light of the similarity of the prior art buffers to the accused buffer, we conclude that no reasonable fact-finder could find that EGI met its burden of showing, by a preponderance of the evidence, that an ordinary observer, taking into account the prior art, would

believe the accused design to be the same as the patented design. In concluding that a reasonable fact-finder could not find infringement in this case, we reach the same conclusion that the district court reached, and for many of the same reasons. Although we do so by using the ordinary observer test as informed by the prior art, rather than by applying the point of novelty test, our analysis largely tracks that of the district court. After analyzing the Nailco patent and the claimed design, as they related to the accused design, the district court concluded that "in the context of nail buffers, a fourth side without a pad is not substantially the same as a fourth side with a pad." While the district court focused on the differences in the particular feature at issue rather than the effect of those differences on the appearance of the design as a whole, we are satisfied that the difference on which the district court focused is important, viewed in the context of the prior art.

Finally, although we do not adopt the "non-trivial advance" test employed by the panel in this case, we note that our analysis under the ordinary observer test is parallel to the panel's approach in an essential respect. The panel focused on viewing the difference between the claimed and accused designs in light of the prior art, as we do. The panel wrote: "The Swisa buffers have raised, abrasive pads on *all four* sides. When considering the prior art in the nail buffer field, this difference between the accused design and the patented design cannot be considered minor." 498 F.3d at 1358. That point captures the essence of the rationale of our decision today, even though the panel decision employed a different analytical approach. For the foregoing reasons, we sustain the district court's entry

of summary judgment of no infringement, but we do so under the ordinary observer test in the form that we have adopted, and without using the point of novelty test that we have disapproved. In the language used by the Supreme Court in *Gorham*, 81 U.S. at 528, we hold that the accused design could not reasonably be viewed as so similar to the claimed design that a purchaser familiar with the prior art would be deceived by the similarity between the claimed and accused designs, "inducing him to purchase one supposing it to be the other."

AFFIRMED.

Footnotes

1This court has required that in determining obviousness, a district court must attempt to "translate [the] visual descriptions into words" in order to communicate the reasoning behind the court's decision and to enable "the parties and appellate courts . . . to discern the internal reasoning employed by the trial court." *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 102 (Fed. Cir. 1996). Requiring such an explanation of a legal ruling as to invalidity is quite different from requiring an elaborate verbal claim construction to guide the finder of fact in conducting the infringement inquiry.

2006-1562

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

EGYPTIAN GODDESS, INC.,
Plaintiff-Appellant,
and ADI TORKIYA,
Third Party Defendant,
v.
SWISA, INC. and DROR SWISA,
Defendants/Third Party Plaintiffs-Appellees

November 26, 2007, Decided

NOTICE: THIS DECISION WAS ISSUED AS UNPUBLISHED OR NONPRECENDENTIAL AND MAY NOT BE CITED AS PRECEDENT. PLEASE REFER TO FEDERAL RULES OF APPELLATE PROCEDURE RULE 32.1 GOVERNING THE CITATION TO UNPUBLISHED OPINIONS.

JUDGES: Before MICHEL, Chief Judge, NEWMAN, Circuit Judge, ARCHER, Senior Circuit Judge, * MAYER, LOURIE, RADER, SCHALL, BRYSON, GAJARSA, LINN, DYK, PROST, and MOORE, Circuit Judges.

PER CURIAM.

ORDER

A combined petition for panel rehearing and rehearing en banc was filed by the Appellant, and a response thereto was invited by the court and filed by the Appellees. The court granted Nike, Inc. and American

Intellectual Property Law Association motions for leave to file briefs as amici curiae.

The petition for rehearing was referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc, response, and the amici curiae briefs were referred to the circuit judges who are authorized to request a poll whether to rehear the appeal en banc. A poll was requested, taken, and the court has decided that it is appropriate for en banc consideration.

Upon consideration thereof,

IT IS ORDERED THAT:

(1) The petition for panel rehearing is denied.

(2) The petition for rehearing en banc is granted.

(3) The court's August 29, 2007 opinion is vacated and the appeal is reinstated.

(4) The parties are requested to file briefs that should address the following questions:

1) Should "point of novelty" be a test for infringement of design patent?

2) If so, (a) should the court adopt the non-trivial advance test adopted by the panel majority in this case; (b) should the point of novelty test be part of the patentee's burden on infringement or should it be an available defense; (c) should a design patentee, in defining a point of novelty, be

permitted to divide closely related or ornamentally integrated features of the patented design to match features contained in an accused design; (d) should it be permissible to find more than one "point of novelty" in a patented design; and (e) should the overall appearance of a design be permitted to be a point of novelty? *See Lawman Armor Corp. v. Winner Int'l, LLC*, 449 F.3d 1190 (Fed. Cir. 2006).

3) Should claim construction apply to design patents, and, if so, what role should that construction play in the infringement analysis? *See Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995).

This appeal will be heard en banc on the basis of briefs addressing, inter alia, the issues set forth above. An original and thirty copies of all briefs shall be filed, and two copies served on opposing counsel. The Appellant shall file a brief within sixty days from the date of filing of this order. The Appellees' brief is due within forty days from the date of service of the Appellant's brief. The Appellant's reply brief, if any, is due within fourteen days from the date of service of the Appellees' brief. Briefs shall adhere to the type-volume limitations set forth in Federal Rule of Appellate Procedure 32 and Federal Circuit Rule 32.

Briefs of amici curiae will be entertained in accordance with Federal Rules of Appellate Procedure 29 and Federal Circuit Rule 29. Scheduling of oral argument, if any, will be resolved at a later date.

Footnotes

*Senior Judge Archer, who was on the original panel, participated only in decision on the petition for panel rehearing.

2006-1562

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

EGYPTIAN GODDESS, INC.,
Plaintiff-Appellant,
and ADI TORKIYA,
Third Party Defendant,
v.
SWISA, INC. and DROR SWISA,
Defendants/Third Party Plaintiffs-Appellees.

August 29, 2007, Decided

JUDGES: Before DYK, Circuit Judge, ARCHER, Senior Circuit Judge, and MOORE, Circuit Judge. Opinion for the court filed by Circuit Judge MOORE. Dissenting opinion filed by Circuit Judge DYK.

OPINION

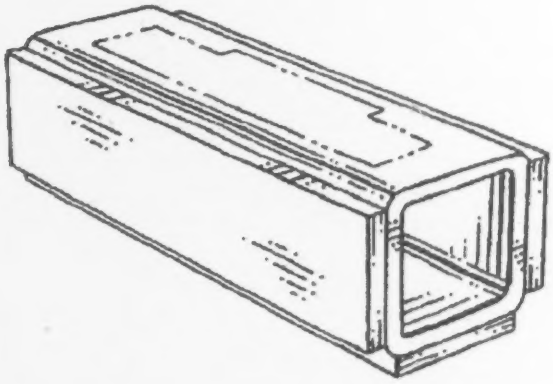
MOORE, *Circuit Judge.*

Appellant Egyptian Goddess, Inc. (EGI) appeals from the final judgment of the United States District Court for the Northern District of Texas, granting summary judgment of noninfringement of U.S. Design Patent No. 467,389 (the D'389 patent) in favor of appellees Swisa, Inc. and Dror Swisa (Swisa). *Egyptian Goddess, Inc. v. Swisa, Inc.*, No. 3:03-CV-0594-N, 2005 U.S. Dist. LEXIS 32931 (N.D. Tex. Dec. 14, 2005) (*Summary Judgment Order*). Because the district court properly determined that there is no genuine issue of material fact as to whether the alleged infringing product

appropriates the point of novelty of the claimed design, we affirm.

BACKGROUND

The D'389 patent covers "an ornamental nail buffer" design as illustrated in the patent's seven figures, one of which is reproduced below.



On March 21, 2003, EGI sued Swisa, claiming that the D'389 patent was infringed by certain Swisa nail buffers. Swisa filed a counterclaim seeking declaratory judgment on various theories, including noninfringement of the D'389 patent. On March 3, 2005, the district court issued a claim construction order, construing the D'389 patent as claiming:

> A hollow tubular frame of generally square cross section, where the square has sides of length S, the frame has a length of approximately 3S, and the frame has a thickness of approximately T = 0.1S; the corners of the cross section are rounded, with the outer corner of the cross

> section rounded on a 90 degree radius of approximately 1.25T, and the inner corner of the cross section rounded on a 90 degree radius of approximately 0.25T; and with rectangular abrasive pads of thickness T affixed to three of the sides of the frame, covering the flat portion of the sides while leaving the curved radius uncovered, with the fourth side of the frame bare.

Neither party challenges the district court's claim construction.

Swisa moved for summary judgment of invalidity and noninfringement -- on the grounds that the accused designs did not infringe the D'389 patent under either the point of novelty or the ordinary observer test. The district court granted summary judgment on the ground that the Swisa nail buffers did not contain the point of novelty of the patented design. Summary Judgment Order, 2005 U.S. Dist. LEXIS 32931 at *6. Specifically, the court stated that "[t]he only point of novelty in the D'389 Patent over the Nailco Patent is the addition of the fourth side without a pad," which the Swisa nail buffers did not have. *Id.* The district court entered a final judgment, dismissing EGI's claims of infringement with prejudice and dismissing Swisa's counterclaims without prejudice. This appeal followed.

We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1). We review the district court's grant of summary judgment de novo. *Winner Int'l Corp. v. Wolo Mfg. Corp.*, 905 F.2d 375, 376 (Fed. Cir. 1990). Summary judgment is appropriate when there are no genuine

issues of material fact and the moving party is entitled to judgment as a matter of law. *Id.*

DISCUSSION

I

There are two distinct requirements for establishing design patent infringement. *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1383 (Fed. Cir. 2004). The first, called the ordinary observer test, requires that "in the eye of an ordinary observer, giving such attention as a purchaser usually gives, [the] two designs are substantially the same . . . the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other." *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528, 20 L. Ed. 731 (1871). The second, called the point of novelty test, requires that "no matter how similar two items look, 'the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.'" *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984) (citing *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395, 396 (8th Cir. 1944)). "Both the ordinary observer and point of novelty tests are factual inquiries that are undertaken by the fact finder during the infringement stage of proceedings, after the claim has been construed by the court." *Bernhardt*, 386 F.3d at 1383.

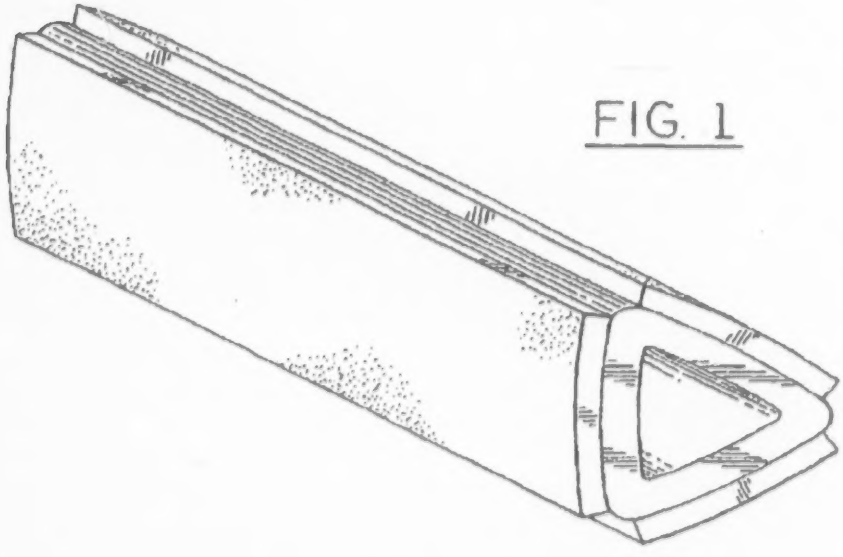
Because the point of novelty determination is part of the infringement analysis, the initial burden is on the patentee to "present, in some form, its contentions as to points of novelty." *Id.* at 1383. The point of novelty can be either a single novel design element or a combination

of elements that are individually known in the prior art. *See Lawman Armor Corp. v. Winner Int'l, LLC*, 449 F.3d 1190, 1192 (Fed. Cir. 2006) (supplemental opinion on petition for rehearing); *Litton*, 728 F.2d at 1443-44. The patentee is not free to set forth any combination of elements as the point of novelty, rather, the point of novelty must include features of the claimed design that distinguish it from the prior art.[1] *Litton*, 728 F.2d at 1444; *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1118 (Fed. Cir. 1998).

For a combination of individually known design elements to constitute a point of novelty, the combination must be a non-trivial advance over the prior art.[2] *See Smith v. Whitman Saddle Co.*, 148 U.S. 674, 682, 13 S. Ct. 768, 37 L. Ed. 606, 1893 Dec. Comm'r Pat. 324 (1893) (analyzing whether the accused device contained the aspects of the claimed design that "rendered it patentable as a complete and integral whole"); *Bernhardt*, 386 F.3d at 1384 (noting that the point of novelty determination "is not especially different from the factual determinations that the district courts routinely undertake" in performing the obviousness inquiry); *cf. Litton*, 728 F.2d at 1444 (applying the results of the obviousness analysis when determining the point of novelty of the claimed design); *Goodyear*, 162 F.3d at 1119, 1121 (noting that the court "adopted the same points of novelty that it had relied on in determining that the '080 patent was not invalid for obviousness," and holding that "the district court did not clearly err in giving weight to those aspects of the '080 tread that were necessary design aspects in sustaining the validity of the patent").[3]

II

The district court properly determined that no reasonable jury could conclude that the point of novelty proffered by EGI is a non-trivial advance over the prior art. The parties do not dispute that the various design elements of the claimed design were each individually disclosed in the prior art. EGI's asserted point of novelty is a combination of four of the claimed design's elements: (1) an open and hollow body, (2) square cross-section, (3) raised rectangular pads, and (4) exposed corners. The district court properly found that one prior art nail buffer design, illustrated in U.S. Design Patent No. 416,648 (the Nailco patent), shown below, contains each of these elements except that the body is triangular -- rather than square -- in cross-section. Summary Judgment Order, 2005 U.S. Dist. LEXIS 32931 at *6.



There is no dispute, however, that nail buffers having square cross-sections were widely known in the prior art. EGI admits that three prior art references cited

during prosecution of the D'389 patent illustrate at least five nail buffer designs with a square cross-section. Moreover, the parties both agree that other well-known prior art designs, namely the Tammy Taylor buffers, also had square cross-sections. In light of the prior art, no reasonable juror could conclude that EGI's asserted point of novelty constituted a non-trivial advance over the prior art. Thus, the district court did not err in rejecting EGI's asserted point of novelty as a matter of law.

The district court correctly determined that only if the point of novelty included a fourth side without a raised pad could it even arguably be a non-trivial advance over the prior art. The Swisa buffers have raised, abrasive pads on *all four* sides. When considering the prior art in the nail buffer field, this difference between the accused design and the patented design cannot be considered minor. *See Litton*, 728 F.2d at 1444 (explaining that the differences between the claimed and accused designs must be considered in light of the differences between the prior art and the claimed design). Since the parties agree that the Swisa buffers do not contain a fourth side without a raised pad, summary judgment of noninfringement was properly granted. For this reason, the decision below is
AFFIRMED.

COSTS

Each party shall bear its own costs.

Footnotes

1Swisa asks this court to forbid the "shopping list approach" to selecting a point of novelty, whereby a patentee strategically selects a point of novelty that consists only of those elements of the claimed design that are also present in the accused design. *See Hosley Int'l Trading Corp. v. K Mart Corp.*, 237 F. Supp. 2d 907, 911-13 (N.D. Ill. 2002); Bush Indus., Inc. v. O'Sullivan Indus., Inc., 772 F. Supp. 1442, 1452 (D. Del. 1991). We agree with Swisa that the point of novelty should be determined by comparing the claimed design to the prior art and not to the accused design. As an appellate court, however, we review the merits of the asserted point of novelty and not the motive behind its selection.

2Contrary to assertions in the dissenting opinion, neither our precedent that utilized the results of an obviousness inquiry in determining the point of novelty nor our holding today is inconsistent with our *Lawman* decision. *Lawman* does not reject a non-trivial test for the point of novelty inquiry, but rather rejects the notion that the suggestion or motivation to combine prior art references must be proven as part of the infringement analysis. Lawman Armor Corp. v. Winner Int'l, LLC, 437 F.3d 1383, 1385 (Fed. Cir. 2006). Rejecting application of the motivation to combine test is not tantamount to rejecting application of an obviousness type analysis. *See* KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741-42, 167 L. Ed. 2d 705 (2007).

3The dissent suggests that determining the point of novelty by a non-triviality test conflates infringement and validity analyses. *Dissenting Op.*, at 2. Design patent law has already intertwined the infringement and validity tests. The infringement test at issue in this

case is called the "point of novelty" test. The question is not whether the infringement and validity analyses are similar or conflated, they already are. The question is: When the patentee claims a combination of old prior art elements as its asserted point of novelty should the test be one of anticipation or obviousness? We conclude that non-triviality ought to apply -- if the standard is akin to anticipation then a combination with even the most trivial difference would meet the standard.

DISSENT BY: DYK

DISSENT

DYK, *Circuit Judge*, dissenting.

This case concerns the scope of the point of novelty requirement in design patents. The majority decides this case on a ground that was not addressed in briefs or at oral argument by either party. In my view, the majority opinion departs from our precedent in fashioning a new rule -- that a combination of elements cannot constitute a point of novelty in design patent cases unless the combination constitutes a "non-trivial advance" over the prior art. The majority equates its newly-fashioned non-trivial advance test with the requirement that a design patent be nonobvious over the prior art. [1] It then appears to limit the application of that test to cases in which the point of novelty involves a combination of prior art elements.

It seems to me that there are multiple flaws in the majority's approach. First, by conflating the criteria for infringement and obviousness, the test eviscerates the statutory presumption of validity by requiring the

patentee to affirmatively prove nonobviousness. *See* 35 U.S.C. § 282 ("The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity."). The burden of proof on obviousness rests with the accused infringer and must be established by clear and convincing evidence. Under the majority's test, however, the patentee would have to prove nonobviousness in order to establish infringement.

Second, the majority's approach is at the same time too narrow and too broad. It is too narrow because it applies a special test only to designs which involve a combination of design elements. It is clear to me that a single point of novelty test must apply to all points of novelty, not just those involving combinations. That has invariably been the approach of our past cases. The majority's approach is also too broad because it extends an obviousness-like test to each point of novelty, not merely the overall design (which is presently the sole focus of the obviousness analysis).

Third, determining whether each combination point of novelty represents a "non-trivial advance" over the prior art requires a difficult and restrictive inquiry in design patent cases. As we have previously noted, "[d]esign patents have almost no scope." *In re Mann*, 861 F.2d 1581, 1582 (Fed. Cir. 1988). Points of novelty in design patents are often not dramatically different from the prior art. It is difficult enough to assess whether an overall design would have been obvious; it is almost impossible to determine whether a particular design feature represents a trivial or substantial advance over the prior art. The majority appears willing to have this issue resolved on summary judgment without

factfinding by a jury, thus relegating to the court the determination whether there is a non-trivial advance over the prior art, a determination which a court is ill suited to make and which it did not in fact make in this case.

Fourth, the majority's test is devoid of support in the case law. The most that any of the cases cited by the majority can establish is that we have, in certain instances, used the results of our obviousness analysis to determine the point of novelty under the point of novelty test. But no case has come close to requiring a showing of nonobviousness as part of the point of novelty test.[2] In *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371 (Fed. Cir. 2004), we considered only the question whether expert testimony was required for a party to establish infringement under the point of novelty test. In holding that such testimony was not required, the court merely observed that "[a] determination of the differences between the patented design and the prior art is not especially different from the factual determinations that district courts routinely undertake *on other issues, such as obviousness.*" *Id.* (emphasis added). This statement in no way suggests -- as the majority appears to believe, *see* Maj. Op. at 5 -- that the substantive inquiries on obviousness and infringement should be merged. Our decisions in *Litton* and *Goodyear* do not support the majority's test either. *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984), was a case in which, having determined that the differences between the patented design and the prior art rendered the overall design nonobvious, *see Graham v. John Deere Co.*, 383 U.S. 1, 17, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966), we then considered those differences to be the points of

novelty. *Litton*, 728 F.2d at 1442, 1444. In *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113 (Fed. Cir. 1998), we held that the use of a similar approach by the district court was not clearly erroneous. *Id.* at 1119, 1121. It is one thing to suggest that a feature that renders a design nonobvious is also a point of novelty. It is quite another to hold that a point of novelty cannot exist unless it would also render the design nonobvious. Again, neither case establishes that there must be a showing of a non-trivial advance to find an asserted combination point of novelty.

Finally, the majority's test is in fact contrary to several of our cases. In *Lawman Armor Corp. v. Winner International, LLC*, 437 F.3d 1383 (Fed. Cir. 2006), we rejected applying an obviousness analysis to the determination of infringement. *Id.* at 1385. We stated explicitly that "[w]hether there is any suggestion to combine prior art references may be relevant in a validity inquiry to determine obviousness . . . but has no place in the infringement issue in this case." *Id.* Other cases have treated the questions of novelty and obviousness in design cases as separate inquiries. Thus in *In re Leslie*, 547 F.2d 116 (CCPA 1977), our predecessor court distinguished situations "where the novelty of the design is at issue" from situations "where, as here, the issue is one of obviousness." *Id.* at 120; *see also In re Blum*, 374 F.2d 904, 908, 54 C.C.P.A. 1231 (CCPA 1967) (although design had "an appearance which is novel in the strictest sense of the word, the rejection here is not for want of novelty but for obviousness").

I would address this case without reliance on the majority's incorrect "non-trivial advance" standard. I respectfully dissent.

Footnotes

1The majority's approach is in fact more restrictive than a nonobviousness test since it takes no account of secondary considerations.

2*Smith v. Whitman Saddle Co.*, 148 U.S. 674, 13 S. Ct. 768, 37 L. Ed. 606, 1893 Dec. Comm'r Pat. 324 (1893), long predated the statutory obviousness requirement.

Civil Action No. 3:03-CV-0594-N

UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS,
DALLAS DIVISION

EGYPTIAN GODDESS, INC.,
Plaintiff,

v.

SWISA, INC., et al.,
Defendants.

December 14, 2005, Decided
December 14, 2005, Filed

JUDGES: David C. Godbey, United States District Judge.

ORDER

Before the Court is the motion for summary judgment of Defendants Swisa, Inc. and Dror Swisa (collectively, "Swisa") on Plaintiff Egyptian Goddess, Inc.'s ("EGI") claims for infringement of United States Design Patent 467,389 (the "D'389 Patent") for a nail buffer. [1] The Court holds that Swisa's allegedly infringing product does not incorporate the point of novelty of the D'389 Patent -- a fourth, bare side to the buffer. Accordingly, the Court grants Swisa's motion without reaching its other noninfringement and obviousness arguments.

I. BACKGROUND

The designs at issue in this case involve simple geometric shapes -- triangles, squares, rectangles, rounded corners. The D'389 Patent is for a fingernail buffer designed to hold buffing pads of different abrasiveness in a way that is easy for the manicurist to hold. [2] A page of the drawings from the D'389 Patent is attached as Exhibit "A."

In its Order of March 3, 2005 (the "Markman Order"), the Court construed the D'389 Patent as follows:

> A hollow tubular frame of generally square cross section, where the square has sides of length S, the frame has a length of approximately 3S, and the frame has a thickness of approximately T = 0.1S; the corners of the cross section are rounded, with the outer corner of the cross section rounded on a 90 degree radius of approximately 1.25T, and the inner corner of the cross section rounded on a 90 degree radius of approximately 0.25T; and with rectangular abrasive pads of thickness T affixed to three of the sides of the frame, covering the flat portion of the sides while leaving the curved radius uncovered, with the fourth side of the frame bare.

Markman Order at 3. In deference to *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371 (Fed. Cir. 2004), the Court declined to address points of novelty in the course of claims construction, but noted the possibility that a court could in an appropriate case and appropriate record address points of novelty at summary judgment. Markman Order at 2 n.1. This now appears to be an appropriate case.

II. POINT OF NOVELTY

A plaintiff in a design patent infringement case must prove both that the accused device is "substantially similar" under the "ordinary observer" test, and that the accused device contains "substantially the same points of novelty that distinguished the patented design from the prior art." *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1121-22 (Fed. Cir. 1998). "The points of novelty relate to differences from prior designs, and are usually determinable based on the prosecution history." *Id.* at 1118. In the context of design patents, "the scope of prior art is not the universe of abstract design and artistic creativity, but designs of the same article of manufacture or of articles sufficiently similar that a person of ordinary skill would look to such articles for their designs." *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1462 (Fed. Cir. 1997). [3]

Unsurprisingly, the parties disagree as to the points of novelty in the D'389 Patent. EGI identifies four design elements, [4] and then for each element identifies prior art that does not embody that element. Based on this reasoning, EGI claims that the point of novelty of the D'389 Patent is the combination of those four elements. *See, e.g., L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124 (Fed. Cir. 1993); *Rubbermaid Commercial Prods. v. Contico Int'l, Inc.*, 836 F. Supp. 1247, 1258-60 (W.D. Va. 1993). Swisa condemns this as an impermissible "shopping list approach." *See, e.g., Bush Indus., Inc. v. O'Sullivan Indus., Inc.*, 772 F. Supp. 1442, 1452-54 (D. Del. 1991); *Int'l Trading Corp. v. K-Mart Corp.*, 237 F. Supp. 2d 907, 911-13 (N.D. Ill. 2002).

The Court need not resolve the "combination vs. shopping list" dispute, because here a single prior reference combines all of EGI's alleged design elements, save one. United States Design Patent No. 416,648 (the "Nailco Patent") discloses a nail buffer with an open and hollow body, raised rectangular pads, and open corners. *See* Exhibit "B" (drawings from the Nailco Patent). EGI cannot claim the combination of those three elements in the D'389 Patent as novel when they were already combined in the Nailco Patent. The only point of novelty in the D'389 Patent over the Nailco Patent is the addition of the fourth side without a pad, thereby transforming the equilateral triangular cross-section into a square. [5] In the context of nail buffers, a fourth side without a pad is not substantially the same as a fourth side with a pad. Because the Swisa product does not include the point of novelty of the D'389 Patent -- a fourth side without a pad -- there is no infringement. Accordingly, the Court grants Swisa's motion for summary judgment. [6]

CONCLUSION

Swisa's motion is not entirely clear which claims and causes of action it intends to address in its motion. EGI originally sued Swisa for infringement. Swisa asserted a reflexive counterclaim for declaratory judgment. Swisa then joined Torkiya as a third-party defendant to its declaratory judgment claims. It appears to the Court that this ruling probably resolves all matters presently in dispute among the parties, but that may not be correct. Accordingly, the Court directs the parties to confer regarding the possibility of an agreed form of judgment consistent with this Order, and if agreement is not possible, to promptly place before the

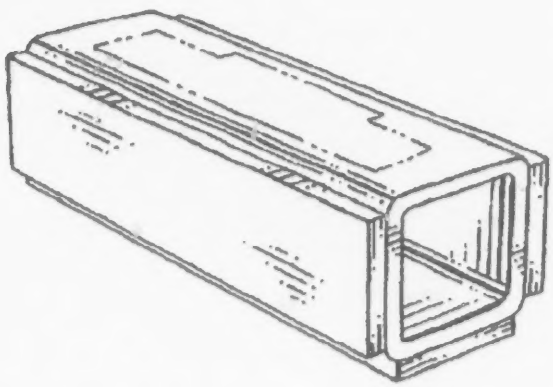
Court any other matters that must be resolved prior to entry of a final judgment.

SIGNED December 14, 2005.

David C. Godbey

United States District Judge

U.S. Patent Dec. 17, 2002 Sheet 1 of 3 US D 467,389 S



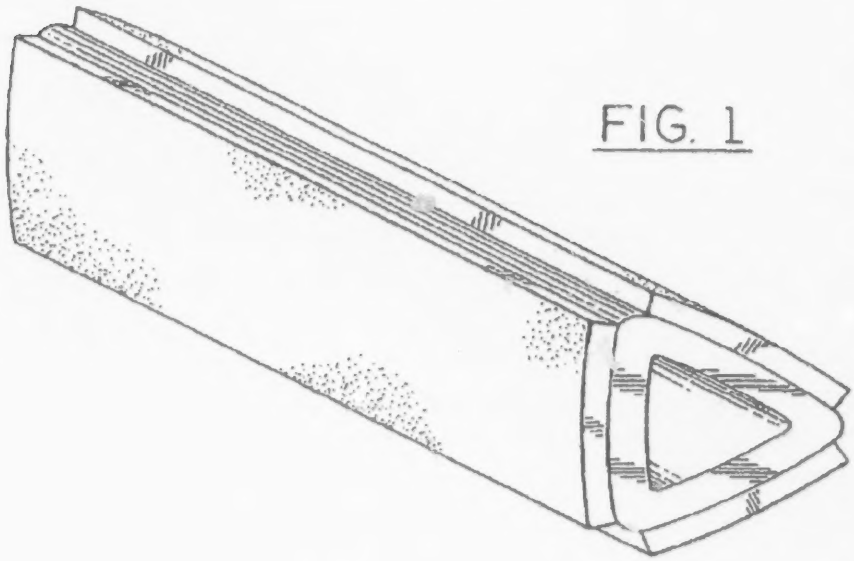


FIG. 1

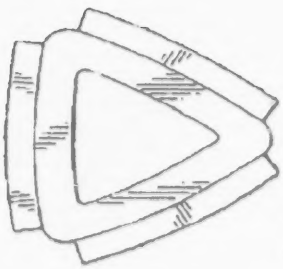


FIG. 2

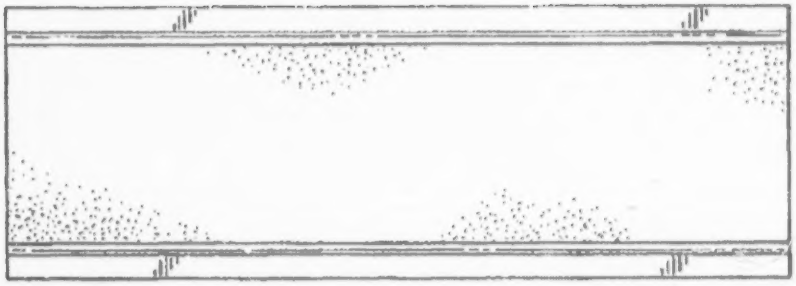


FIG. 3

Exhibit "B" -- The Nailco Patent

2006-1562

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

EGYPTIAN GODDESS, INC.,
Plaintiff-Appellant,
and ADI TORKIYA,
Third Party Defendant,
v.
SWISA, INC. and DROR SWISA,
Defendants/Third Party Plaintiffs-Appellees.

November 4, 2008, Filed

NOTICE: THIS DECISION WAS ISSUED AS UNPUBLISHED OR NONPRECEDENTIAL AND MAY NOT BE CITED AS PRECEDENT. PLEASE REFER TO FEDERAL RULES OF APPELLATE PROCEDURE RULE 32.1 GOVERNING THE CITATION TO UNPUBLISHED OPINIONS.

ORDER

A petition for rehearing en banc of the court's September 22, 2008, opinion, having been filed by the Appellant,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on November 12, 2008.